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Confirmation By Hand Delivery

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Kovesdi et al.

Confirmation No.: 3522

Serial No.: 10/035,952

Art Unit: 2876

Filed: December 26, 2001

Examiner: K. Koyama

For: SYSTEM AND METHOD FOR
AUTHORING AND PROVIDING
INFORMATION RELEVANT TO
A PHYSICAL WORLD

Attorney Docket No.: 802959-999002

**REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. § 1.47(A),
FOR REMOVAL OF A JOINT SIGNATURE REQUIREMENT AND ENTRY OF A
PREVIOUSLY SUBMITTED RESPONSE TO OFFICE ACTION, AND FOR
SUSPENSION OF PROSECUTION UNDER 37 C.F.R. § 1.183**

Commissioner for Patents
P. O. Box 1450
Alexandria, Va 20231

Dear Sir:

Inventor Rozsa Kovesdi respectfully requests the Commissioner to grant this application a 37 C.F.R. § 1.47(a) status, or in the alternative to remove the joint signature requirement currently in place and to allow her representatives to prosecute the application on behalf of herself and co-inventor Ajit Rajasekharan. In particular, it is respectfully requested that a response to the outstanding Office Action, which representatives of Ms. Kovesdi filed on September 18, 2003 be entered without the signature of co-inventor Rajasekharan. Unless the requested relief is granted, the application would likely become abandoned, causing irreparable harm to her interests in the inventions claimed therein, and would leave her with no opportunity to request the Patent Office to resolve the disputed inventorship. To prevent this application from going abandoned before the Patent Office can rule on the instant submission, petitioner Kovesdi urgently requests the Commissioner to suspend its prosecution under 37 C.F.R. § 1.103.

The core issue to be resolved is whether petitioner Kovesdi is entitled to seek an opportunity to have a potential inventorship dispute between her and Mr. Rajasekharan resolved by the Patent Office. The underlying facts are simple: in July 2001 Ms. Kovesdi and Mr. Rajasekharan filed a provisional application naming both as inventors. In November 2001, Mr. Rajasekharan filed a non-provisional application that claims priority from the joint provisional application but lists him as the sole inventor (the '597 application). Ms. Kovesdi filed the present application (the '952 application) in December 2001 also claiming priority of the joint provisional application and listing both herself and Mr. Rajasekharan as co-inventors. As efforts to agree on a joined prosecution of the '952 application failed, Ms. Kovesdi filed a petition under 37 C.F.R. § 1.47(a) to prosecute the application on behalf of both inventors. Subsequently, Mr. Rajasekharan petitioned to join in the '952 application, expressly stating that he is the sole inventor "of a substantial number of the presented claims including all independent claims." Mr. Rajasekharan's petition further requested the Patent Office to require both parties to sign all subsequent replies under MPEP § 402.10, stating that "this requirement will encourage the parties to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources."

Despite the fact that Mr. Rajasekharan's request appears to violate MPEP § 409.03(i) which directs a party asserting sole inventorship of claims in a joint application to resolve the issue in a different patent application, the Patent Office denied Ms. Kovesdi's § 1.47(a) petition, granted Mr. Rajasekharan's petition to join, and imposed a requirement that all subsequent papers in this application be signed by both parties. By contrast, the Patent Office denied Ms. Kovesdi's petition to join in the '597 application as a co-inventor, allegedly because she was not a "proper party in interest." This determination was not based on the merits of her request to join, but solely on the fact that the originally filed declaration in the '597 application did not list Ms. Kovesdi as a co-inventor.

As a result of the above procedures, Ms. Kovesdi was placed in the anomalous position of not having even an opportunity to present for resolution to the Patent Office any potential issues of inventorship, because her co-inventor effectively has a veto power over any submission to the Patent Office. Indeed, the prosecution of the '952 application before the Patent Office has demonstrated that Mr. Rajasekharan's previous statement that a joint signature requirement would "encourage the parties to work out a jointly submitted

amendment” simply meant that Ms. Kovesdi would have no choice, and based solely on his own allegations Mr. Rajasekharan could resolve any issue in his favor.

In particular, in response to a rejection of the claims in the ‘952 application, Mr. Rajasekharan has taken the position that only two out of 107 claims in this application were jointly invented, and has refused to sign any response that does not involve the cancellation of the remaining claims in favor of prosecuting the claimed subject matter in his own ‘597 application. Mr. Rajasekharan has taken this position despite the fact that he has acknowledged in writing that a substantive response addressing all claims in the application and prepared by Ms. Kovesdi’s representatives is technically accurate. The Patent Office did not enter Ms. Kovesdi’s response because it did not have the signatures of both inventors. At present, facing a new deadline to respond to the same Office Action, Ms. Kovesdi’s options appear to be: letting the application go abandoned (and irreparably damaging her interest in the subject matter claimed therein), or canceling virtually all claims in the application and expressly acknowledging Mr. Rajasekharan’s alleged sole inventorship.

The above alternatives are testament of what can go wrong if the Patent Office’s rules of practice are applied inconsistently or fail to take into account the equities in a case. These rules of practice are intended to protect the rights of the parties and the fairness of the process, not to unfairly treat one party for the benefit of another. Accordingly, in view of the Mr. Rajasekharan’s refusal to cooperate in the prosecution of this application, and to protect the interests of Ms. Kovesdi as an innocent co-inventor risking a complete loss of rights through no fault of her own, it is respectfully requested that the ‘952 application be granted 37 C.F.R. § 1.47(a) status and/or that the joint signature requirement be removed, allowing Ms. Kovesdi’s previously filed response to be entered. To prevent this ‘952 application from going abandoned, it is respectfully requested that its prosecution be suspended under 37 C.F.R. § 1.103.

STATEMENT OF FACTS

1. Petitioner Rozsa Kovesdi filed the present application, Serial No. 10/035,952 (the ‘952 application) on December 26, 2001, claiming priority of provisional application Ser. No. 60/306,356, filed July 18, 2001 (the ‘356 application). In a declaration to the Patent Office Ms. Kovesdi listed herself and Mr. Ajit Rajasekharan as co-inventors of the ‘952

application; the same two are listed as co-inventors of the provisional '356 application, which has identical disclosure and claims. (Exh. A).

2. After attempts to reach out to Mr. Rajasekharan failed, on May 1, 2002 Ms. Kovesdi's filed a petition under 37 C.F.R. § 1.47(a) asking to prosecute the application on behalf of herself and the non-signing inventor. (Exh. B).

3. On June 4, 2002 Mr. Rajasekharan filed a petition under 37 C.F.R. § 1.182 in the '952 application, asking for appointment of a power of attorney by less than all applicants. The petition stated that Mr. Rajasekharan desires his own representation to prosecute the '952 application, because he is the sole inventor "of a substantial number of the presented claims including all independent claims," and that "a portion of the solely conceived claims are being prosecuted in a copending U.S. utility patent application" naming him as the sole inventor. Mr. Rajasekharan's June 4 petition also requested that both parties be required to sign all subsequent replies under MPEP §402.10, stating that "this requirement will encourage the parties to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources." (Exh. C, p.2).

4. The Patent Office dismissed Mr. Rajasekharan's June 4 petition, because the declaration filed along with this petition omitted Ms. Kovesdi as an inventor. In the same document the Patent Office invited Mr. Rajasekharan to consider filing his own application in case he believed the inventorship of the '952 application to be in error. (Exh. D).

5. On August 23, 2002, Mr. Rajasekharan filed a second, substantially similar petition under 37 C.F.R. § 1.182, which included a newly executed declaration, listing both himself and Ms. Kovesdi as co-inventors of the '952 application. (Exh. E).

6. On September 17, 2002, the Patent Office granted Mr. Rajasekharan's second 37 C.F.R. § 1.182 petition, dismissed Ms. Kovesdi's 37 C.F.R. § 1.47(a) petition, and imposed a requirement that all further correspondence be signed by representatives of both parties. (Exh. F).

7. The first Office Action in the '952 application, issued on March 18, 2003, rejecting all pending claims of the application. (Exh. G).

8. Mr. Rajasekharan provided a draft response to the Office Action on May 21, 2003, proposing to cancel all pending claims except dependent claims 43 and 44, and to include a statement that the canceled claims are pursued in U.S. Patent Application Ser. No. 09/987,597, listing Mr. Rajasekharan as the sole inventor. (Exh. H, p.3). This draft response is the first time Mr. Rajasekharan stated his contentions concerning the inventorship of the claims in the '952 application, and included no support for these contentions.

9. Ms. Kovesdi's representatives drafted a separate response addressing all pending claims and provided this draft response to Mr. Rajasekharan for review and signature on September 15, 2003. (Exh. I).

10. On September 17, 2003 representatives of both parties discussed the response proposed by Ms. Kovesdi on the phone, and agreed that the response was not objectionable. On that basis, and to prevent the application from going abandoned for failure to respond, Ms. Kovesdi's representatives filed in the Patent Office the discussed response, although it was not signed by both parties. (Exh. J).

11. On September 22, 2003 Mr. Rajasekharan's representatives sent a letter insisting that their draft of the response should be filed, stating that "[a]lthough we find your technical arguments for overcoming the outstanding prior art rejections are not incorrect or inconsistent with the technical positions that Mr. Rajasekharan has taken in his case, the overall approach of this response is certainly adverse to Mr. Rajasekharan's interests as it continues Ms. Kovesdi's pursuit of claims solely conceived by Mr. Rajasekharan, i.e., renumbered claims 1-42 and 45-70." (Exh. K). Ms. Kovesdi's representatives filed on the same day a supplemental response to the Office Action, including a copy of the September 22 letter, and asked the Patent Office to accept it in lieu of Mr. Rajasekharan's signature. (part of Exh. K).

12. On December 16, 2003, the Patent Office issued an Office Action, stating that while the September 18 and 22, 2003 reply "appears to be *bona fide*," it lacked the signatures of both parties. The examiner gave applicants one month to correct. (Exh. L).

13. Representatives of Ms. Kovesdi have been unable to obtain Mr. Rajasekharan's signature, despite diligent efforts. In particular, following the December 16, 2003 Office Action, representatives of Ms. Kovesdi unsuccessfully requested Mr. Rajasekharan in letters dated January 6, 2004 and April 1, 2004 respectively and in other

communications, to sign the admittedly correct response they have prepared to the Office Action in the '952 application. (Exh. M).

14. On January 12, 2004, the Patent Office rejected Ms. Kovesdi's petition to join as a co-inventor in Application Ser. No. 09/987,597, listing Mr. Rajasekharan as the sole inventor. The rejection is on the ground that she is not a "proper party in interest" apparently because she was not listed on the first executed declaration in this application. The Patent Office expressly stated that it did not consider the petition to join as a co-inventor on the merits. (Exh. N).

15. In March and early April 2004, representatives of both parties communicated again on issues related to the contested inventorship but were unable to reach an agreement. In particular, in a letter of April 8, 2004, Mr. Rajasekharan's representatives informed Ms. Kovesdi that the acceptable options in the '952 application are: (1) to cancel the claims that allegedly are solely Mr. Rajasekharan's contribution; (2) sign a joint petition to suspend the prosecution of the application; and (3) sign a joint request for the filing of a continuation application. The April 8 letter also states that "[i]f you refuse to cooperate on all of these proposals, it is likely that the application will become irrevocably abandoned." (Exh. O).

16. Unless a response to the Office Action dated December 16, 2003 is entered in the '952 application by June 16, 2004, the application will become abandoned.

ARGUMENT

1. Section 1.47 (a) Status Is Proper Because Mr. Rajasekharan Has Refused to Cooperate in the '952 Application

37 C.F.R. 1.47 (a) provides that if a "joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor." Although Mr. Rajasekharan was allowed to join in the '952 application, his refusal to cooperate on any substantive matter during its means that *de facto* Mr. Rajasekharan refuses to join in this application. Thus, for the reasons set forth below, Section 1.47 (a) status of the '952 application is warranted.

The facts in the prosecution of the ‘952 application unambiguously establish that after Mr. Rajasekharan was allowed to join in by decision of the Patent Office dated September 17, 2002 (Exh. F), he has consistently obstructed the prosecution of the ‘952 joint application in favor of his ‘597 application, in which he is listed as the sole inventor. Specifically, in response to a March 18, 2003 Office Action in the ‘952 application, Mr. Rajasekharan has asserted repeatedly that the only response acceptable to him is to cancel all but two claims in the application in favor of prosecuting the claimed subject matter in his ‘597 application. *See* response drafted by Mr. Rajasekharan’s representatives dated May 21, 2003, which draft includes an express statement that the canceled claims are pursued in U.S. Patent Application Ser. No. 09/987,597 (Exh. H); *see also* subsequent correspondence in Exh. J, where commenting on an alternative draft response proposed by Ms. Kovesdi, Mr. Rajasekharan’s representatives stated that they “find [the] technical arguments for overcoming the outstanding prior art rejections are not incorrect or inconsistent with the technical positions that Mr. Rajasekharan has taken in his case,” but would not cooperate because prosecuting such claims in the joint application is against Mr. Rajasekharan’s interests; *see also* Mr. Rajasekharan’s letter of April 8, 2004 (Exh. O), which gives Ms. Kovesdi only three options in this case: (1) to cancel the claims that allegedly are solely Mr. Rajasekharan’s contribution; (2) sign a joint petition to suspend the prosecution of the application; or (3) sign a joint request for the filing of a continuation application. As noted, the April 8, 2004 letter also states that “[i]f you refuse to cooperate on all of these proposals, it is likely that the application will become irrevocably abandoned.” (Exh. O).

Clearly, unless Ms. Kovesdi agrees with his unilateral assertion of sole inventorship of virtually all claims, Mr. Rajasekharan is going to ensure that no substantive response can be filed. Ms. Kovesdi respectfully requests that the facts concerning the prosecution of the ‘952 application be accepted as proof of refusal under MPEP 409.03 (d).

The above facts are plainly inconsistent with Mr. Rajasekharan properly joining the ‘952 application, in fact they virtually define a joint inventor who “refuses to join in an application” and indicate that he may have “joined in” the ‘952 application simply to prevent its normal prosecution on the merits. Thus, inventor Kovesdi respectfully submits that granting a Section 1.47(a) status of the ‘952 application is necessary to protect her interests - holding otherwise would be contrary to the spirit the rules of patent practice and would be demonstrably inequitable.

Likewise, the joint signature requirement pursuant to MPEP 402.10, which applies in this case is intended to protect the interests of parties who have retained separate representation. Mr. Rajasekharan has refused to sign any joint responses to the Patent Office in the '952 application that do not involve canceling of all claims that he has unilaterally decided to be his own invention. His insistence that these claims be canceled unquestionably is injurious to Ms. Kovesdi's interests in the claimed subject matter, in favor of those of Mr. Rajasekharan, which are admittedly protected in a separate, '597 application. Mr. Rajasekharan's unilateral determination of the issues, based solely on its own allegations is undoubtedly wrong and contrary to Patent Office's rules and practice.

For the foregoing reasons, Ms. Kovesdi respectfully requests that she be allowed to prosecute the application on behalf of herself and Mr. Rajasekharan without the joint signature requirement.

2. The Decision to let Mr. Rajasekharan Join in the '952 Application Was In Error

The '952 application should be granted Section 1.47(a) status also because the Patent Office's September 17, 2002 decision allowing Mr. Rajasekharan to join in the application (Exh. F) was improper and violates MPEP 409.03 (i).

Mr. Rajasekharan's first and second Section 1.182 declarations filed on June 4 and August 23, 2002 respectively (Exh. C and Exh. E), included an express statement that he is the sole inventor of "a substantial number of claims including all independent claims." This declaration also included a statement that he has already filed a patent application (apparently the '597 application, which was not identified at the time) directed "to a portion of the solely conceived claims."

MPEP 409.03 (i) provides that "if a nonsigning inventor feels that he or she is the sole inventor of an invention claimed in a 37 CFR 1.47 application naming him or her as a joint inventor, a nonsigning inventor may file his or her own application and request that he is or her application be placed in interference with the 37 CFR 1.47 application. If the claims in both the nonsigning inventor's application and the 37 CFR 1.47 application are otherwise found allowable, an interference may be declared."

It is clear therefore, that the Patent Office erred in allowing Mr. Rajasekharan to join in this application, because the Patent Office was already on notice that he “feels that he is the sole inventor” and has already filed a separate application covering a portion of the “solely conceived claims.” Ms. Kovesdi had no notice of the actual claims that appear in dispute until the April 8, 2004, when Mr. Rajasekharan confirmed which claims he considers his sole invention, and stated that unless Ms. Kovesdi agrees to “cooperate” with his unilateral decision, the joint ‘952 application will go abandoned or will be suspended until allowable subject matter is indicated in his ‘597 application. (Exh. O).

Accordingly, Ms. Kovesdi respectfully requests submits that Section 1.47(a) is warranted for the additional reason that the Patent Office’s decision to allow Mr. Rajasekharan to join in the ‘952 application was in error.

3. Unless the Request is Granted, Ms. Kovesdi Will Suffer Irreparable Harm

Mr. Rajasekharan’s April 8, 2004 letter (Exh. O) states that unless Ms. Kovesdi agrees to cancel the claims that he believes are his sole invention, “the application will become irrevocably abandoned.” With a pending deadline to respond to an Office Action and a requirement that both co-inventors sign any such response (Exh. L), it is clear that the ‘952 application may be abandoned through no fault of Ms. Kovesdi’s, unless the Patent Office intervenes without a delay. Abandonment without question will cause irreparable harm to Ms. Kovesdi’s interests in the application and any inventions described therein.

Furthermore, the joint signature requirement in the ‘952 application effectively leaves Ms. Kovesdi with no possibility to raise the inventorship issue before the Patent Office. Mr. Rajasekharan’s interests are protected in the co-pending ‘597 application that Ms. Kovesdi was not allowed to join. In contrast, Ms. Kovesdi cannot even raise the issue, because to do so in the ‘952 application would require Mr. Rajasekharan’s consent. But in the very first submission made in this application (Exh. C) Mr. Rajasekharan has expressed his preference “to work out a jointly submitted amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources” - in other words, to avoid interference and prosecution by Ms. Kovesdi. Working out a joint solution is one thing, precluding the other party’s choice in this matter, as appears to be Mr. Rajasekharan’s intention in this application, is quite another. Removing even the opportunity to present any issue for resolution before

the Patent Office is clearly inequitable, it is contrary to the spirit and letter of the Patent Office's rules and practice and should not be allowed.

In addition, it has come to Ms. Kovesdi's attention that a second patent application, Ser. No. 10/103,777 (the '777 application) has been filed on March 25, 2002, as a continuation-in-part of the '597 application. The '777 application also does not list Ms. Kovesdi as an inventor although it appears that subject matter claimed in at least some claims of the application was contributed by her. Mr. Rajasekharan and Readia, the company that seems to be the assignee of his applications, have already put Ms. Kovesdi on notice that the "ground rules" for her to be considered as co-inventor in the '597 and '777 applications would involve her providing documentary support of all her contributions (apparently for review by Mr. Rajasekharan or Readia) (Exh. O).

Finally, under Federal Circuit precedent Ms. Kovesdi may also lose any potential interest in the patent or patents that may issue from the '597 application, because of the possibility that such patents may be declared unenforceable. *See, Frank's Casing Crew and Rental Tools, Inc. v. PMR Technologies, Ltd.*, 63 USPQ.2d 1065, 1069 (Fed. Cir. 2002) ("if unenforceable due to inequitable conduct, a patent may not be enforced even by innocent co-inventors.").

Conclusion

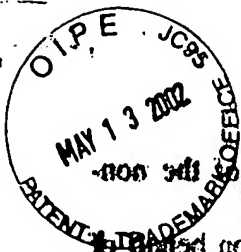
For the foregoing reasons, Ms. Kovesdi respectfully requests that the '952 application be granted a 37 C.F.R. § 1.47(a) status, or in the alternative that the Patent Office removes the joint signature requirement currently in place to allow her representatives to prosecute the application on behalf of herself and co-inventor Ajit Rajasekharan. No fee is believed due with this submission. Please charge any required fees to Jones Day Deposit Account No. 503013. A copy of this submission is also being served on the representatives of Mr. Rajasekharan.

Date April 16, 2004

Respectfully submitted,

for *Rath Voth* *Reg. No. 43,827*
Ognjan V. Shentov

JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939/(212) 790-9090



(4)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

The undersigned hereby certifies that the undersigned is the inventor of the invention described in the foregoing application.

Applicant: Kovesdi et al.)

Examiner: Not yet assigned

Serial No.: 10/035,952)

Filed: December 26, 2001)

Title: System And Method For)

Information Relevant To A)

Physical Description)

Abstract)

Claims)

Drawings)

References)

Remarks)

PETITION UNDER 37 CFR 1.47(a)

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In accordance with 37 CFR 1.47(a), the inventor Rozsa Kovesdi hereby petitions to make application for patent on behalf of herself and the named inventor Ajit Rajasekharan. The fee set forth in 37 CFR 1.17(i) is enclosed herewith.

A diligent effort has been made to obtain the signed Declaration of Mr. Rajasekharan. This effort included the sending of mail to the attorney for Mr. Rajasekharan, namely, Roger Tate of Brobeck, Phleger & Harrison at 1333 H. Street, N.W. Suite 800, Washington, DC 20005. Efforts were not made to contact Mr. Rajasekharan directly owing to his representation by counsel in this matter. Despite this effort, as evidenced by the attached letter which was mailed to the attorney for Mr. Rajasekharan and the certified mail, restricted delivery, return receipt, Mr. Rajasekharan has not responded to the request to secure his signature on the accompanying Declaration.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Kovesdi et al.)	
)	Examiner: Not yet assigned
Serial No.:	10/035,952)	
)	Art Unit: Not yet assigned
Filed:	December 26, 2001)	
)	Atty Docket: 66566.01US2
Title:	System And Method For)	
	Authoring And Providing)	
	Information Relevant To A)	
	Physical World)	

PETITION UNDER 37 CFR 1.47(a)

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

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The signing of the Declaration by Ms. Kovesdi with the signature block of the non-signing inventor left blank is to be treated as having been signed by Ms. Kovesdi on behalf of Mr. Rajasekharan.

The undersigned further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application, any patent issued thereon, or any patent to which this declaration is directed.

Respectfully submitted,

Date: MAY 1, 2002

By: 
Rozsa Kovesdi

PATENT & TRADEMARK
MAY 13 2002
JCS

GARY R. JAROSIK
(312) 715-4522
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FAX: (312) 715-4800

April 22, 2002

Via Certified Mail
Return Receipt Requested

Rodger Tate, Esq.
Brobeck, Phleger & Harrison LLP
1333 H Street, N.W.
Suite 800
Washington, DC 20005

Re: **U.S. Patent Application Serial No. 10/035,952**
Title: SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING
INFORMATION RELEVANT TO A PHYSICAL WORLD
Our File No.: 66566.01US2

Dear Mr. Tate:

Enclosed please find a copy of the above-referenced patent application and a copy of the Combined Declaration for the signature of Mr. Ajit Rajasekharan. Once Mr. Rajasekharan has signed the Declaration, I kindly ask that the Declaration be returned to my attention for filing with the United States Patent Office.

The subject patent application was filed on December 26, 2001 and claims priority to U.S. provisional patent application Serial No. 60/306,356. As you are aware, the provisional patent application correctly names both Rozsa Kovesdi and Ajit Rajasekharan as inventors.

It is our understanding that Mr. Rajasekharan has filed a patent application that also claims priority to this provisional patent application. It is our further understanding that Mr. Rajasekharan has represented to the United States Patent Office that he is the "sole" inventor of the subject matter recited in the claims of said patent application. However, we call your attention to the fact that Mr. Rajasekharan has admitted on several occasions that Ms. Kovesdi must be considered to be an inventor of the subject matter that is recited in the claims of the provisional patent application. For example, in a correspondence dated August 31, 2001, Mr. Rajasekharan stated:

Mr. Rodger Tate
April 22, 2002
Page 2

"The system patent - the one we already filed. There is no doubt in my mind about who its inventors are - Rozi and Ajit in equal measure."

"The overall device patent - not yet filed, I am supposed to have long completed it and I have not. This is the subsidiary patent to the system patent and shares the same descriptions as the system patent - though Ajit may have a larger contribution in this patent as Rozi herself persistently claims, the evolution of ideas were a consequence of our constant combined thinking. So I would state that there was equal contribution to that too."

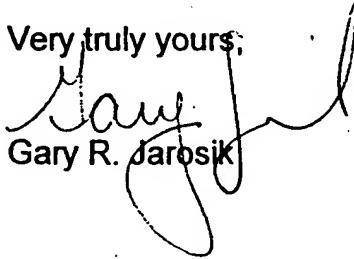
"In fact, even with both our contributions to the system and device patent - there have been several instances where I would say some statement which may not have a direct relevance to a claim but it would trigger the right idea in you and vice versa. Most of the claims in our system are the results of such confluences of both our ideas - to me it is a futile exercise to dissect them apart and say who contributed what."

Since you have informed us that the claims set forth in the patent application filed by Mr. Rajasekharan are identical to those found in the provisional patent application and, as such, identical to those in the subject patent application, we request that Mr. Rajasekharan either: 1) add Rozsa Kovesdi as an inventor in the patent application that he has filed; or 2) withdraw his previously filed patent application in favor of the subject patent application.

We believe that these corrective measures are required to protect the property interests of Ms. Kovesdi and Mr. Rajasekharan under the Patent Law while also providing an amicable resolution to this matter.

If you have any questions, please call me.

Very truly yours,


Gary R. Jarosik

GNM
Enclosures

Is your RETURN ADDRESS completed on the reverse side?

SENDER:

- **Cx** Items 1 and/or 2 for additional services.
- **Co** Items 3, 4a, and 4b.
- Print your name and address on the reverse of this form so that we can return this card to you.
- Attach this form to the front of the mailpiece, or on the back if space does not permit.
- Write "Return Receipt Requested" on the mailpiece below the article number.
- The Return Receipt will show to whom the article was delivered and the date delivered.

I also wish to receive the following services (for an extra fee):

1. ☐ Addressee's Address
2. ☐ Restricted Delivery

Consult postmaster for fee.

3. Article Addressed to:

Rodger Tate, Esq.
Borbeck, Phlegg & Harrison LLP
1333 H. Street, N.W., #800
Washington, D.C. 20005

4a. Article Number

7001 0360 0001 2277 3148

4b. Service Type

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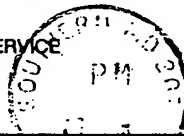
X *Reg Jones*

8. Addressee's Address (Only if requested and fee is paid)

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Rodger Tate, Esq.

Street, Apt. No.,
or PO Box No.

1333 H. Street, N.W.

City, State, ZIP+4

Washington, D.C. 20005

PS Form 3800, January 2001

See Reverse for Instructions

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PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/035,952
Filing Date	12/26/2001
First Named Inventor	Kovesdi et al.
Group Art Unit	2876
Examiner Name	unassigned
Attorney Docket Number	66566.01US2

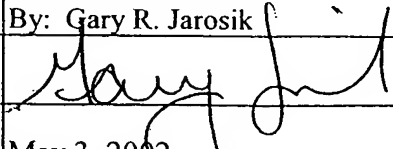
Total Number of Pages in This Submission 9

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input checked="" type="checkbox"/> Response to Missing Parts/ Incomplete Application <input checked="" type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input checked="" type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): - Copy of Missing Parts Notice - return postcard
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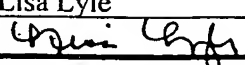
Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

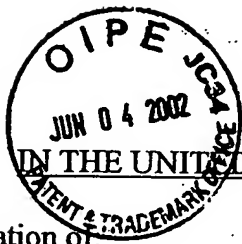
Firm or Individual name	Customer No. 25541 By: Gary R. Jarosik
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Date	May 3, 2002

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: 05/03/2002

Typed or printed name	Lisa Lyle	
Signature		Date 05/03/2002

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



#6

In re Application of:)
)
Ajit RAJASEKHARAN, et al.) Group Art Unit: To Be Assigned
)
Application Number: 10/035,952) Examiner: To Be Assigned
)
Filed: December 26, 2001)

For: SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING INFORMATION
RELEVANT TO A PHYSICAL WORLD

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JUN 18 2002

OFFICE OF PETITIONS

**PETITION UNDER 37 C.F.R. § 1.182 FOR APPOINTMENT OF
A POWER OF ATTORNEY BY LESS THAN ALL APPLICANTS**

Attention: Office of Petitions
U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

Mr. Ajit Rajasekharan ("Applicant") petitions the Commissioner under 37 C.F.R. § 1.182 to accept Applicant's appointment of representation included in the Declaration and Power of Attorney document concurrently submitted herewith in the above-captioned patent application. Particularly, Applicant requests that the U.S. Patent & Trademark Office (PTO) accept Applicant's power of attorney, which is signed by only one of the two applicants of the present application for the reasons provided below.

Applicant submits that his rights to the claimed subject matter of the present application are better served by the appointment of representatives other than those appointed by joint applicant, Ms. Rozsa Kovesdi. Particularly, Applicant desires his own representation to prosecute the present application on his behalf and to formally join the prosecution under the provisions of MPEP § 402.10. Because Applicant maintains that he is the sole inventor of a substantial number of the presented claims including all independent claims¹, allowing Ms. Kovesdi's appointed representative(s) to prosecute the application on the behalf of both Applicants will misrepresent and possibly irreparably harm Mr. Rajasekharan's exclusive rights to the claimed subject matter solely conceived by him.

¹ A portion of the solely conceived claims are being pursued in a copending U.S. utility patent application naming Applicant as the sole inventor.

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705/2002 HEIZUNES 00000024 10035352

130.00 DP

FC:122

Acceptance of Applicant's power of attorney will result in two parties prosecuting the present application at the same time. Accordingly, Applicant respectfully requests that the Commissioner require both parties to sign all subsequent replies submitted to the PTO in accordance with MPEP § 402.10. Applicant contends that this requirement will encourage the parties to work out a jointly submitted Amendment that properly limits the claims presented in this application to those jointly conceived by Mr. Rajasekharan and Ms. Kovesdi, thereby, avoiding waste of PTO time and resources.

Check No. 1931 in the amount of \$130.00 is enclosed to cover the petition fee set forth in 37 C.F.R. § 1.17(h). In the event that any variance exists between the amount enclosed and the amount determined by the PTO to consider the present Petition, the Commissioner of Patents is hereby authorized to charge or credit such variance to the undersigned's Deposit Account No. 50-1640.

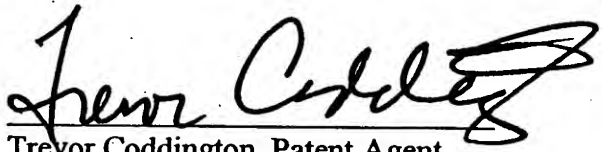
Respectfully submitted,

BROBECK, PHLEGER & HARRISON LLP

June 4, 2002

Brobeck, Phleger & Harrison LLP
Intellectual Property Department
1333 H Street, N.W., Suite 800
Washington, D.C. 20005
Tel: (202) 220-6000
Fax: (202) 220-5200

By:


Trevor Coddington, Patent Agent
Registration No. 46,633

TC:cdh

0910

2876

PATENT
ATTORNEY DOCKET: 66566.01US2



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

Ajit RAJASEKHARAN, et al.

Application Number: 10/035,952

Filed: December 26, 2001

For: SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING INFORMATION
RELEVANT TO A PHYSICAL WORLD

Group Art Unit: To Be Assigned

Examiner: To Be Assigned

**RESPONSE TO NOTICE TO FILE MISSING
PARTS OF NONPROVISIONAL APPLICATION**

Attention: Box Missing Parts
U.S. Patent and Trademark Office
Washington, D.C. 20231

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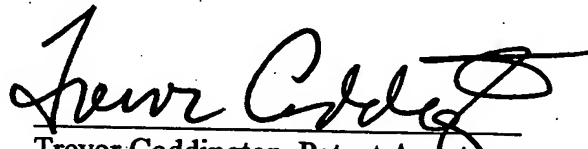
Sir:

In response to the attached Notice To File Missing Parts of Nonprovisional Application mailed April 4, 2002, Mr. Ajit Rajasekharan submits herewith an executed Declaration and Power of Attorney for the above-captioned patent application. Payment of the late filing surcharge and Ms. Rozsa Kovesdi's Declaration should be provided with a separate Response to Notice to File Missing Parts filed on Ms. Rozsa Kovesdi's behalf.

Respectfully submitted,
BROBECK, PHLEGER & HARRISON LLP

June 4, 2002

Brobeck, Phleger & Harrison LLP
Intellectual Property Department
1333 H Street, N.W., Suite 800
Washington, D.C. 20005
Tel: (202) 220-6000
Fax: (202) 220-5200

By: 
Trevor Coddington, Patent Agent
Registration No. 46,633

TC:cdh

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APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/035,952	12/26/2001	Ajit Rajasekharan	66566.01US2

25541
ALTHEIMER & GRAY
TEN SOUTH WACKER DRIVE, SUITE 4000
CHICAGO, IL 60606-7482

CONFIRMATION NO. 3522

FORMALITIES LETTER



OC000000007794785

Date Mailed: 04/04/2002

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is unsigned.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(l) of \$65 for a small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 65.

*A copy of this notice **MUST** be returned with the reply.*

Wkoren
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PART 2 - COPY TO BE RETURNED WITH RESPONSE

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Attorney Docket No.: 033393.0005

Prior United States Application(s)

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s), or § 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) which occurred between the filing date of the prior application and the national or PCT International filing date of this application:

Application Number	Date of Filing (day, month, year)	Status - Patented, Pending, Abandoned

And I hereby appoint Rodger L. Tate, Registration No. 27,399; Anthony W. Shaw, Registration No. 30,104; Cono A. Carrano, Registration No. 39,623; Laurence H. Posorske, Registration No. 34,698; Robert A. King, Registration No. 42,738; and Craig L. Puckett, Reg. No. 43,023, as my attorneys; and Trevor Q. Coddington, Registration No. 46,633, as my patent agent; of BROBECK, PHLEGER & HARRISON LLP, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith.

All correspondence and telephone communications should be addressed to:

BROBECK, PHLEGER & HARRISON LLP
Intellectual Property Department
1333 H Street, N.W.; Suite 800
Washington, DC 20005
telephone number (202) 220-6000
facsimile number (202) 220-5200,

which is also the address, telephone and facsimile numbers of each of the above listed attorneys and agent.

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BROBECK, PHLEGER & HARRISON LLP
Intellectual Property Department
1333 H Street, N.W.
Suite 800
Washington, D.C. 20005
(202) 220-6000 (telephone); (202) 220-5200 (facsimile)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signature

Date 05/24/02Full Name of
First Inventor:RAJASEKHARAN
(Family Name)Ajit
(First Given Name)V.
(Second Given Name)

Citizenship:

India

Residence:

137 Windsong Circle, East Brunswick, New Jersey 08816

Post Office
Address:

137 Windsong Circle, East Brunswick, New Jersey 08816



UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 8

ALTHEIMER & GRAY
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CHICAGO IL 60606-7482

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AUG 16 2002

OFFICE OF PETITIONS

In re Application of
Kovesdi and Rajasekharan
Application No. 10/035,952
Filed: 26 December, 2001
Attorney Docket No. 66566.01US2

ON PETITION

This is a decision on the petition filed on 4 June, 2002, under 37 CFR 1.182, requesting acceptance of a power of attorney made on behalf of less than all the named inventors.

The petition under 37 CFR 1.182 is **DISMISSED AS MOOT**.

The petition is dismissed as moot because applicant Rajasekharan does not appear to have joined in the filing of the above-identified application. 37 CFR 1.41(a)(1) now defines the inventorship of a non-provisional application as that inventorship set forth in the oath or declaration filed to comply with the requirements of 37 CFR 1.63. On 13 May, 2002, a declaration was filed naming Rozsa Kovesdi and Ajit Rajasekharan as joint inventors. As the declaration filed with the present petition lists Rajasekharan as the sole inventor, that declaration does not list the proper inventive entity, and therefore does not comply with 37 CFR 1.63.

If applicant Rajasekharan believes the inventorship of the above-identified application is in error, he may wish to consider filing his own application.

All parties are reminded that dual correspondence will not be undertaken by the USPTO. A courtesy copy of this decision is being forwarded to the address listed on the petition. All future correspondence, however, will be mailed solely to the address of record.

Application No. 10/035,952

2

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination

cc: Trevor Coddington
Brobeck, Phleger & Harrison, LLP
1333 H Street, N.W., Suite 800
Washington, D.C. 20005



10

PATENT

ATTORNEY DOCKET: 66566.01US2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ajit RAJASEKHARAN, et al.

Application Number: 10/035,952

Filed: December 26, 2001

For: SYSTEM AND METHOD FOR
AUTHORING AND PROVIDING
INFORMATION RELEVANT TO A
PHYSICAL WORLD

Group Art Unit: Unknown

Examiner: Unknown

SECOND PETITION UNDER 37 C.F.R. § 1.182 FOR APPOINTMENT
OF A POWER OF ATTORNEY BY LESS THAN ALL APPLICANTSAttention: Office of Petitions
U.S. Patent and Trademark Office
Washington, D.C. 20231RECEIVED
AUG 26 2002
OFFICE OF PETITIONS

Sir:

In view of the newly executed Declaration and Power of Attorney document concurrently submitted herewith, Mr. Ajit Rajasekharan ("Applicant") hereby petitions the Commissioner under 37 C.F.R. § 1.182 to accept Applicant's appointment of representation in the above-captioned patent application. Particularly, Applicant requests that the U.S. Patent & Trademark Office (PTO) accept Applicant's power of attorney, which is signed by only one of the two applicants of the present application for the reasons provided below.

To recap the relevant procedural history of the present patent application, a Declaration was filed on behalf of Ms. Rozsa Kovesdi on May 13, 2002, naming Rozsa Kovesdi and Ajit Rajasekharan as joint inventors. Applicant filed a Declaration on June 4, 2002 (Mr. Rajasekharan's "First Declaration"), declaring himself as a joint inventor. See Mr. Rajasekharan's First Declaration, page 1 ("I believe that I am an original, first, and joint inventor of the subject matter to which at least one claim is directed ..."). Emphasis added. However, the inventive entity set forth in Mr. Rajasekharan's First Declaration failed to identify Ms. Kovesdi as a joint inventor.

3/26/2002 CCHAU1 00000004 10035952

1 FC:122

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Applicant submitted a Petition under 37 C.F.R. § 1.182 on June 4, 2002 (the "First Petition"), to formally join the prosecution under the provisions of MPEP § 402.10. The First Petition was dismissed as moot in the PTO's Decision mailed August 16, 2002, on the grounds that Mr. Rajasekharan's First Declaration does not list the proper inventive entity, and therefore does not comply with 37 C.F.R. § 1.63. Particularly, because Mr. Rajasekharan's First Declaration does not identify the same inventive entity as that set forth in Ms. Kovesdi's Declaration, the PTO contends that Mr. Rajasekharan's First Declaration is improper.

Applicant submits concurrently herewith a newly executed Declaration (Mr. Rajasekharan's "Second Declaration"), which identifies Mr. Rajasekharan and Ms. Kovesdi as the inventive entity. Mr. Rajasekharan's Second Declaration is identical to the First Declaration except that Ms. Kovesdi is now identified in the named inventive entity. The failure to identify Ms. Kovesdi within the inventive entity named in Mr. Rajasekharan's First Declaration was unintentional. Because Mr. Rajasekharan's Second Declaration identifies the same inventive entity as that set forth in Ms. Kovesdi's Declaration, Applicant maintains that this Second Declaration complies with the requirements of 37 C.F.R. § 1.63.

Applicant respectfully requests that the PTO grant the present petition and require that a representative of Ms. Kovesdi and a representative of Mr. Rajasekharan must both sign any subsequent replies in accordance with MPEP § 402.10. Applicant maintains that his rights to the claimed subject matter of the present application are better served by the appointment of representatives other than those appointed by joint applicant, Ms. Rozsa Kovesdi. Particularly, Applicant desires his own representation to prosecute the present application on his behalf because he is the sole inventor of a substantial portion of the presented claims including all independent claims. Allowing Ms. Kovesdi's appointed representative(s) to prosecute the application on the behalf of both Mr. Rajasekharan and Ms. Kovesdi will misrepresent and possibly irreparably harm Mr. Rajasekharan's exclusive rights to the claimed subject matter solely conceived by him.

Check No. 015018 in the amount of \$130.00 is enclosed to cover the petition fee set forth in 37 C.F.R. § 1.17(h). In the event that any variance exists between the amount enclosed and the amount determined by the PTO to consider the present Petition and/or to enter Mr. Rajasekharan's Second Declaration, the Commissioner for Patents is hereby authorized to charge or credit such variance to the undersigned's **Deposit Account No. 50-1640**.

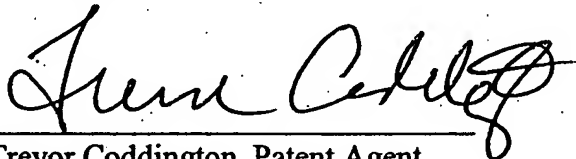
Respectfully submitted,

BROBECK, PHLEGER & HARRISON LLP

August 23, 2002

Brobeck, Phleger & Harrison LLP
Intellectual Property Department
1333 H Street, N.W., Suite 800
Washington, D.C. 20005
Tel: (202) 220-6000
Fax: (202) 220-5200

By:



Trevor Coddington, Patent Agent
Registration No. 46,633

11

Attorney Docket No.: 66566.01US2

DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As the below named inventor, I hereby declare that:

My residence, post office address and citizenship is: as stated below next to my name;

I believe that I am an original, first, and joint inventor of the subject matter to which at least one claim is directed and for which a patent is sought on the invention entitled:

**SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING INFORMATION
RELEVANT TO A PHYSICAL WORLD**the specification of which: ☐ is attached hereto.☒ was filed on:December 26, 2001

as Application No.:

10/035,952

and was amended on: _____

(if applicable).

I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56.

Prior Foreign Application(s)

I hereby claim foreign priority benefits under Title 35, United States Code, § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below any foreign application(s) for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Country	Application Number	Date of Filing (day, month, year)	Date of Issue (day, month, year)	Priority Claimed	
				Yes <input type="checkbox"/>	No <input type="checkbox"/>
				Yes <input type="checkbox"/>	No <input type="checkbox"/>

Prior Provisional Application(s)

I hereby claim the benefit under Title 35, United States Code § 119(e) of any United States provisional application(s) listed below:

Application Number	Date of Filing (day, month, year)
60/306,356	July 18, 2001

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OFFICE OF PETITIONS

Prior United States Application(s)

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s), or § 365(c) of any PCT International application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) which occurred between the filing date of the prior application and the national or PCT International filing date of this application:

Application Number	Date of Filing (day, month, year)	Status - Patented, Pending, Abandoned

And I hereby appoint Rodger L. Tate, Registration No. 27,399; Anthony W. Shaw, Registration No. 30,104; Cono A. Carrano, Registration No. 39,623; Laurence H. Posorske, Registration No. 34,698; Robert A. King, Registration No. 42,738; and Craig L. Puckett, Reg. No. 43,023, as my attorneys; and Trevor Q. Coddington, Registration No. 46,633, as my patent agent; of BROBECK, PHLEGER & HARRISON LLP, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith.

All correspondence and telephone communications should be addressed to:

BROBECK, PHLEGER & HARRISON LLP
Intellectual Property Department
1333 H Street, N.W.; Suite 800
Washington, DC 20005
telephone number (202) 220-6000
facsimile number (202) 220-5200,

which is also the address, telephone and facsimile numbers of each of the above listed attorneys and agent.

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Intellectual Property Department
1333 H Street, N.W.
Suite 800
Washington, D.C. 20005
(202) 220-6000 (telephone); (202) 220-5200 (facsimile)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signature



Date 08/21/02

Full Name of
First Inventor:

RAJASEKHARAN
(Family Name)

Ajit
(First Given Name)

V.
(Second Given Name)

Citizenship:

India

Residence:

137 Windsong Circle, East Brunswick, New Jersey 08816

Post Office

Address:

137 Windsong Circle, East Brunswick, New Jersey 08816

Signature

Date

Full Name of
First Inventor:

KOVESDI
(Family Name)

Rozsa
(First Given Name)

(Second Given Name)

Citizenship:

United States

Residence:

70 Derby Court, Madison, New Jersey 07940

Post Office

Address:

70 Derby Court, Madison, New Jersey 07940

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UNITED STATES PATENT AND TRADEMARK OFFICE

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ALTHEIMER & GRAY
TEN SOUTH WACKER DRIVE, SUITE 4000
CHICAGO IL 60606-7482

Paper No. 12
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SEP 17 2002

OFFICE OF PETITIONS

In re Application of : DECISION NOTING JOINDER OF
Kovesdi and Rajasekharan : INVENTOR AND PETITION UNDER
Application No. 10/035,952 : 37 CFR 1.47(a) MOOT
Filed: 26 December, 2001 : AND DECISION GRANTING
Attorney Docket No. 66566.01US2 : PETITION UNDER 37 CFR 1.182

This is a decision on the renewed petition under 37 CFR 1.47(a) and 1.182 filed on 23 August, 2002.

The petition under 37 CFR 1.47(a) is DISMISSED AS MOOT.

The petition under 37 CFR 1.182 is GRANTED.

Papers filed on 23 August, 2002, in response to the Decision Under 37 CFR 1.47(a) and 1.182 mailed on 16 August, 2002, included a Declaration signed by the previously non-signing inventor, Rajasekharan, in compliance with 37 CFR 1.63.

In view of the joinder of the inventor, further consideration under 37 CFR 1.47(a) is moot; this application does not have any rule 1.47(a) status and no such status should appear on the file wrapper. This application need not be returned to this office for any further consideration under 37 CFR 1.47(a).

Petitioners should note that the order of inventors' names was established by the declaration filed on 13 May, 2002.

The declaration under 37 CFR 1.63 filed on 13 May, 2002, naming Rosza Kovesdi and Ajit Rajasekharan as joint inventors was signed by joint inventor Kovesdi and gave power of attorney to, *inter alia*, Robert E. Browne (Browne et al.) Of Altheimer & Gray, 10 South Wacker Drive, Suite 4000, Chicago, IL 60606-7482, as the correspondence address of record.

Petitioner Ajit Rahasekharan by way of Trevor Q. Coddington, Rodger L. Tate, Anthony W. Shaw, Cono A. Carrano, Laurence H. Posorske, Robert A. King, and Craig L. Puckett (Coddington et al.) of Brobeck, Phleger & Harrison LLP, 1333 H Street, NW, Suite 800, Washington, DC 20005, assert that a dispute has arisen between Rajasekharan and Kovesdi and seeks to require that all

correspondence filed in this application be signed by representatives of both joint inventors.

In accordance with MPEP 402.10, to assure that all interests are properly and effectively represented, **all further correspondence to the U.S. Patent and Trademark Office (USPTO) must be signed by petitioner's representative (Coddington et al.) as named in the declaration and power of attorney submitted on 23 August, 2002, and likewise signed by Browne et al. who remain Kovesdi's representative. Each attorney signing subsequent papers must indicate whom he or she represents.**

All parties are reminded that dual correspondence is not permitted and will not be undertaken by the USPTO.

The USPTO will continue to conduct correspondence with the attorneys first named in the application, i.e., Browne et al., at the correspondence address of record noted above, who will also be responsible for coordinating replies or submissions to the USPTO.¹

It is noted that, notwithstanding this decision, the inventors may still **jointly** appoint or revoke a power of attorney.

The application is being forwarded to Technology Center 2800 for examination in due course.

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Brobeck, Phleger & Harrison LLP
Intellectual Property Department
1333 H Street, N.W., Suite 800
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¹See MPEP 402.10.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KOYAMA, KUMIKO C

ART UNIT PAPER NUMBER

2876

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

128

Office Action Summary

Application No.

10/035,952

Applicant(s)

KOVESDI ET AL.

Examiner

Kumiko C. Koyama

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 23, 24, 25...69, 70, 71 have been renumbered 22, 23, 24...68, 69, 70 respectively.

Double Patenting

2. A rejection is based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-31, 33-42 and 45-70 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-70 of copending Application No. 09/987597. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 18, 19, 21, 22, 31, 34, 38, 54 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu (US 5,480,306, as cited by the Applicant).

Liu teaches a method and apparatus for providing information relevant to a physical world by reading a bar code associated with a sound data and the code is converted into a memory address pointer pointing to the initial address of the memory area in which the digital sound or pronunciation is stored and the sound applied to a loud speaker system (col 2 lines 35+). Liu teaches that the bar code is printed on visible media, such as paper and plastic slides. The conversion from the bar code to the digital code then to an address pointer is considered be normalizing a read object label associated with object into an object identifier as discussed above. And placing the object identifier into an index table repository and binding the content to the object identifier are taught in Fig 5A and Fig 5B.

Re claim 19: Liu teaches that the language learning apparatus contains a digital sound data memory means (col 6 lines 30-32).

Re claim 54: Liu teaches that the memory control means 5 may properly retrieve the desired digital speed data of the word from the memory means 6, which inherently shows that there is not pattern or sequential order for accessing, therefore it is randomly accessible.

Re claim 58: The apparatus is a purpose build device targeted to read bar code.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 9, 13, 16, 29, 30, 39-42, 59, 60, 63-64 and 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (US 5,480,306) in view of Savchenko et al (US 6,111,567).

Liu teaches a method and apparatus for reading a bar code associated with a sound data and the code is converted into a memory address pointer pointing to the initial address of the memory area in which the digital sound or pronunciation is stored, converted to an analog signal, and the sound applied to a loud speaker system (col 2 lines 35+). The apparatus 10 is considered to be a circuitry. Liu teaches that the bar code is printed on visible media, such as paper and plastic slides. Liu teaches that the apparatus having a memory and a speaker means for outputting the sound (col 6 lines 22-59).

Liu fails to teach a method for authoring information and a system for authoring the content.

Savchenko teaches methods of authoring multimedia titles (col 1 lines 8-10).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order

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to create a well organized system so that minimal memory is utilized, but at the same time provide a good quality sound and maintain the flow of the music or sound produced.

Re claim 2 and 3: Liu fails to teach that the system for authoring content is resident in the apparatus.

Savchenko teaches that the execution instructions for the authoring tool are contained in the memory (col 4 lines 39-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to provide a multifunctional apparatus so that the user may author and playback the sound according to his/her preference utilizing only one apparatus, which avoids complicated connections between multiple devices.

Re claim 9: Liu fails to teach that the step of storing the content in non-volatile memory resident in the apparatus.

Savchenko teaches that a computer application 42 is stored in the non-volatile memory 34 (col 4 lines 37-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to safely store the content so that the content is not easily changed or modified by others.

Re claim 13: Savchenko further teaches a computer readable storage media having instructions for authoring information (col 4 lines 39-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order

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to speed up the process by storing all the instruction in the memory and have the processor access and execute the instructions instead of loading or inputting the instructions one-by-one by the user.

Re claim 16, 29 and 30: In addition to Liu as modified by Savchenko discussed above, the conversion from the bar code to the digital code then to an address pointer is considered be normalizing a read object label associated with object into an object identifier as discussed above. And placing the object identifier into an index table repository and binding the content to the object identifier are taught in Fig 5A and Fig 5B.

Re claim 42: Liu teaches that rendering digital multimedia as a function of output capabilities of the apparatus (col 6 lines 50-58).

Liu fails to teach programming that renders digital multimedia as a function of output capabilities.

Savchenko teaches a computer application 42 that executes instructions (col 4 lines 36-45).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to provide the proper sound signal that matches the output characteristics of the apparatus so that the user can listen to a good quality sound with less background noise and interruption.

Re claim 63: Liu teaches that a keyboard for inputting information (col 1 lines 13-25).

8. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 above and Liu as applied to claim 18, and further in

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view of Cave (US 5,958,014). Liu as modified by Savchenko and Liu have been discussed above.

Liu as modified by Savchenko and Liu fail to teach that the content is a link to a live agent.

Cave teaches device having audio capabilities and can be connected to a live agent (col 1 lines 65+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cave to the teachings of Liu as modified by Savchenko in order to provide a two-way audio or text exchange to communicate with each other without remembering or dialing numbers, which also makes the process faster.

9. Claims 7, 14, 36, 37, 49 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 and 13 above and Liu as applied to claim 38, and further in view of Conley, Jr. et al (US 6,434,745).

Liu teaches receiving a plurality of optical codes (col 7 line 45).

Therefore, it would have been obvious to utilize the steps of Liu as modified by Savchenko and repeat steps for as many coded labels necessary because it is a mere duplication of process.

Liu as modified by Savchenko fails to teach aggregating the content into a single logical entity called a tour.

Conley teaches that a tour component of the browser 8 allows the end-user to identify one or more URLs and save them into a group called a tour and to create one or more such tours, and

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to save each tour to a searchable local tour database on the end-user computer 14 similar to the searchable local image database.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Conley to the teachings of Liu as modified by Savchenko in order to organize the data so that related data are grouped in the same group. Such modification helps and speeds up the searching process when the data needs to be retrieved because the data are

10. Claims 8, 15, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 and 13 above and Liu as applied to claim 31 above, and further in view of Brooks et al (US 4,963,719).

Liu as modified by Savchenko fails to teach detecting a second label associated with the first object and normalizing the first label and the second label such that the content bound to the first object can be rendered during detection of either the first or second label in the playback mode.

Brooks teaches two labels associated with the same object, two labels attached to an object and detecting two of the labels (Fig 2, col 2 lines 26+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Brooks to the teachings of Liu as modified by Savchenko so that plurality of bar code labels having the same sound or data may be provided on different or multiple appliances for duplication or convenience purposes.

11. Claim 10, 11, 12, 20, 25, 45-47 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 and 64 above and over

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Liu as applied to claim 18, 38 above, and further in view of Cluts (US 5,616,876). Liu as modified by Savchenko and Liu have been discussed above.

Re claim 10, 20, 45 and 65: Liu as modified by Savchenko and Liu fail to teach a step of uploading and downloading the content to a remote server.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Savchenko because a remote server may provide more memory or storage space, which allows more data and information to be stored.

Re claim 11 and 47: Liu as modified by Savchenko fails to teach that the step of uploading is performed via a wireless network.

Cluts teaches a communication link is wireless (col 7 lines 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Savchenko because it does not require wired connection, therefore provides mobility and convenience.

Re claim 12 and 46: Liu as modified by Savchenko fails to teach that the step of uploading is performed via a wired network.

Cluts teaches a communication link is wired (col 7 lines 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by

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Savchenko because the possibility of data loss or corruption in transferred data decreases, therefore the modification provides a more accurate transmission of the data.

Re claim 25: Liu fails to teach that the step of rendering the content comprises streaming the content from a remote server.

Savchenko teaches rendering the content comprise streaming the content (col 1 lines 28-31).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to transmit the sound file through communication links using industry standards, such as MPEG standards.

Liu as modified by Savchenko fails to teach a remote server.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Savchenko because a remote server may provide more memory or storage space, which allows more data and information to be stored.

12. Claims 17, 62 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claims 16, 59 and 64 above, and further in view of Bridgelall (US 6,264,106). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fail to disclose that the instructions allow a plurality of different label types to be normalized to one object identifier.

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Bridgelall teaches a combination bar code scanner/RFID circuit for reading bar code or RFID (col 2 lines 20+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Bridgelall to the teachings of Liu as modified by Savchenko because bar code and RFID tags are commonly known forms of identification and combining those two functions into one device will provide the flexibility of reading different types of codes.

13. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 18 above, and further in view of Fan et al (US 6,324,165). Liu has been discussed above.

Liu fails to teach determining the current time and comparing the current time to the timestamp before rendering the content.

Fan teaches a timer issuing a current time and a comparator for comparing the queue timestamp to the current time (col 27 lines 7-12).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Fan to the teachings of Liu in order to provide a data that corresponds to the current time by checking to see if the current time and timestamp corresponds to each other.

14. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 18 above, and further in view of Boulton et al (US 5,566,291). Liu has been discussed above.

Liu further teaches that the language learning apparatus contains a digital sound data memory means (col 6 lines 30-32).

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Liu fails to teach that the steps of accepting annotations/feedback after the rendering of the content and binding the annotations/feedback to the object identifier.

Boulton teaches an object identifier field 200 that stores an object identifier which references an object the user may be referencing with his or her feedback information. In Boulton's feedback system, objects can be used to further define the context when the feedback is provided (col 25 lines 55+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Boulton to the teachings of Liu in order to enhance the content and provide a better quality sound, image, etc. to the user by editing or making additional comments to the content.

15. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Boulton as applied to claim 26 above, and further in view of Cluts.

Liu as modified by Boulton fails to disclose the step of storing the annotations/feedback in a remote memory.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Boulton because a remote server may provide more memory or storage space, which allows more data and information to be stored.

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16. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 31 above, and further in view of Swartz et al (US 6,095,418). Liu has been discussed above.

Liu fails to teach that at least one of the plurality of labels is custom created.

Swartz teaches translating the MIDI code to a symbol data and to music print data. The printer 26 then prints the symbol data as symbol 14.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Swartz to the teachings of Liu in order to provide custom created bar code so that information regarding the content's location within the database or other information may be encoded according to the program or application that is used for the system.

17. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 38 above, and further in view of Hollander (US 4,037,302) and Blum (US 4,654,727). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fail to teach that the physical world comprises labeled locations containing labeled mobile objects and the labeled locations are used to determine proximity of the labeled mobile objects.

Holland teaches labeled locations, such as labeled bin or labeled shelf (col 4 lines 48-51).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Holland to the teachings of Liu as modified by Savchenko in order to identify the purpose, use or the physical description of the location of the labeled location so that the locations can easily and quickly identified.

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Blum teaches that a bar code label on the cassette is read by a bar code reader in order to enable a computer control system to determine the location of the cassette and control the subsequent transport of cassettes to the tape transports (col 1 lines 40-45).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Blum to the teachings of Liu as modified by Savchenko in order to quickly and easily determine the location of the object by using the bar code label as a tracking method, which also avoids the object from getting lost.

18. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko and Cluts as applied to claim 47 above, and further in view of Aguirre et al (US 6,195,531). Liu/Savchenko/Cluts have been discussed above.

Liu/Savchenko/Cluts fails to teach that the wireless network comprises a cellular telephone network.

Aguirre teaches a cellular telephone network (col 3 lines 26-40).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Aguirre to the teachings of Liu/Savchenko/Cluts because it is a widely used wireless network method for providing a safe and reliable data transmission, which enhances the accuracy of the data being transmitted.

19. Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Cole et al (US 6,359,711). Liu have been discussed above.

Liu fails to disclose that the apparatus accesses the tour via the internet and a voice portal.

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Cole teaches a portable computer with access methods of voicemail and internet (col 2 lines 10-15).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cole to the teachings of Liu because it is a fast method to communicate and transmit data using a conventional phone line, which is commonly available.

20. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Aguirre and Cole.

Liu fails to teach that the apparatus accesses the tour via a cellular telephone voice mailbox.

Aguirre teaches a cellular telephone network (col 3 lines 26-40).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Aguirre to the teachings of Liu/Savchenko/Cluts because it is a widely used wireless network method for providing a safe and reliable data transmission, which enhances the accuracy of the data being transmitted.

Cole teaches a portable computer with access methods of voicemail and internet (col 2 lines 10-15).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cole to the teachings of Liu because it is a fast method to communicate and transmit data using a conventional phone line, which is commonly available.

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21. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Krueger (US 5,598,540). Liu has been discussed above.

Liu fails to teach that the digital multimedia is accessible by the apparatus in a sequential order.

Krueger teaches accessing the stored data only in sequential order (Abstract).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Krueger to the teachings of Liu in case presentation of the digital multimedia must be in a certain order for the user to understand certain topics before achieving the next data so that the next data makes more sense to the user.

22. Claims 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Ramachandran (US 6,315,195). Liu has been discussed above.

Liu fails to teach that the apparatus comprises a personal digital assistant and a cellular telephone.

Ramachandran teaches a portable terminal 14 that reads bar codes and also may be integrated into a carrier 62, which may be a personal digital assistant or a cellular phone (col 8 lines 23-26, col 9 lines 35-42).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Ramachandran to the teachings of Liu because both personal digital assistant and cellular phones have the capability of storing information and also wirelessly transmitting information through internet and other communication methods, which enhances the voice data and play back as well.

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23. Claims 61 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 59 and 64 above, and further in view of Chen et al (US 5,869,820). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fails to teach that the circuitry comprises an IR tag reader.

Chen teaches an infrared tag reader (col 8 line 5).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Chen to the teachings of Liu as modified by Savchenko because IR tags are readily available tags that are also used for identification purposes and it utilizes wireless communication, which provides mobility and faster process.

24. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 64 above, and further in view of Bertram et al (US 5,613,137). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fails to teach a circuitry determining a coordinate location.

Bertram teaches a coordinate determining circuitry 302 configured to determine corresponding locations of the touch on the coordinate sensor (col 15 lines 20-28).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Bertram to the teachings of Liu as modified by Savchenko in order to determine the location of the touch pad sensor input that provides the information regarding the identification of the content to be retrieved and played back.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Savchenko et al., U.S. Patent No. 6,343,298, discloses a seamless multimedia branching.

Kikuda, U.S. Patent No 4,952,785, discloses a bar code generating apparatus for image communication terminal device.

Raistrick et al., U.S. Patent No. 5,971,279, discloses a hand held scanner for the visually impaired.

Citron et al., U.S. Patent No. 5,288,976, discloses a bar code use in information, transactional and other system and service applications.

Kunizawa et al., U.S. Patent No. 4,964,167, discloses an apparatus for generating synthesized voice from text.

Knowles discloses a hand-held portable www access terminal with visual display panel an gui-based www browser program integrated with bar code symbol reader in a hand-supportable housing.

Hoda et al., U.S. Patent No. 4,831,610, discloses method and apparatus for interactive control of a data recording medium playback apparatus using bar code access.

Barton et al., U.S. Patent No. 5,998,752, discloses a sorting system.

Dyko et al, U.S. Patent No. 5,956,708, discloses an integration of link generation cross-author user navigation, and reuse identification in authoring process.

Art Unit: 2876

Wilz, Sr. et al., U.S Patent No. 5,992,752, discloses an internet-based system for enabling information-related transactions over the internet using java-enabled internet terminals provided with reading java-applet encoded bar code symbols.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 703-305-5425. The examiner can normally be reached on Monday-Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

kck
March 7, 2003

Waiene I. Lee
Diane I. Lee
Primary Examiner
GAU 2876

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO:** Assistant Commissioner for Patents, Washington, DC 20231.



HUNTON & WILLIAMS LLP
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TEL 202 • 955 • 1500
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RODGER L. TATE
DIRECT DIAL: 202-419-2069
EMAIL: rtate@hunton.com

FILE NO: 63044.5

May 21, 2003

Rattan Nath
Pennie & Edmonds LLP
1155 Avenue of the Americas
New York, N.Y. 10036-2711

Re: U.S. Patent Application No. 10/035,952 ("the '952 application")
Filed: December 26, 2001
Entitled: SYSTEM AND METHOD FOR AUTHORING AND PROVIDING
INFORMATION RELEVANT TO A PHYSICAL WORLD
Your Ref.: 11326-003
Our Ref.: 63044.5

Dear Mr. Nath:

In order to maintain a clear line of demarcation between the '952 application and related U.S. Patent No. 09/987,587 ("the '587 application"), all claims solely conceived by Mr. Rajasekharan in the '952 application, *i.e.*, renumbered claims 1-42 and 45-70, need to be cancelled in the next response. Enclosed is a Response that we have prepared. The Response cancels claims 1-42 and 45-70 and provides arguments for overcoming the outstanding rejection of the remaining claims. We request that you sign this Response as required under MPEP § 402.10 and return it to us for filing with the United States Patent & Trademark Office.

Sincerely,

Rodger L. Tate

RLT/TQC:mia
Enclosures



HUNTON & WILLIAMS LLP
1900 K STREET, N.W.
WASHINGTON, D.C. 20006-1109

TEL 202 • 955 • 1500
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RODGER L. TATE
DIRECT DIAL: 202-419-2069
EMAIL: rtate@hunton.com

May 21, 2003

FILE NO: 63044.2

Rattan Nath
Pennie & Edmonds LLP
1155 Avenue of the Americas
New York, N.Y. 10036-2711

Re: U.S. Patent Application No. 09/987,587 ("the '587 application")
Filed: November 15, 2001
Entitled: SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING
INFORMATION RELEVANT TO A PHYSICAL WORLD
Inventor: Ajit Rajasekharan
Our Ref.: 63044.2

Dear Mr. Nath:

In response to your correspondence dated April 21, 2003, Mr. Rajasekharan maintains that the inventorship set forth in his original declaration is correct and legally proper in view of the subject matter presented in the claims of the above-identified application. Therefore, it would be improper for him to execute a new declaration stating otherwise as you request.

We wish to remind you that the '587 application does not include any claims that were conceived in part by Ms. Kovesdi. The only claims of U.S. Provisional Application No. 60/306,356 that Ms. Kovesdi arguably made a conceptual contribution to are claims 44 and 45, which are not being pursued in the '587 application. Due to the absence of these claims, the claims of the '587 application vis-à-vis those in U.S. Patent Application No. 10/035,952 are not substantially identical as you state in your Petition under 37 C.F.R. § 1.182.

Because prosecution of the '587 application is conducted *ex parte*, we find no reason at this time to substantively respond to the merits of your improper Petition.

Sincerely,

Rodger L. Tate

RLT/TQC:mia

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:)	
)	
Rozsa KOVESDI and Ajit RAJASEKHARAN)	Group Art Unit: 2876
)	
Application Number: 10/035,952)	Examiner Kumiko C. KOYAMA
)	
Filed: December 26, 2001)	Confirmation No. 3522
)	
For: SYSTEM AND METHOD FOR)	
AUTHORING AND PROVIDING)	
INFORMATION RELEVANT TO A)	
PHYSICAL WORLD)	

REPLY TO NON-FINAL OFFICE ACTION UNDER 37 C.F.R. § 1.111

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed on March 18, 2003, Applicants respectfully request entry of the following amendments.

IN THE CLAIMS:

Please enter the claim amendments as provided on the following pages and in the simplified amendment format as set forth by the Deputy Commissioner. See Pre-OG Notice, January 31, 2003 (discussing the PTO's proposed revision to and waiver of current 37 C.F.R. § 1.121). No new matter has been added by these amendments as they are fully supported by the original claims.

Claims 43 and 44 are amended as follows.¹

Claims 1-42 and 45-70 have been cancelled.

Claims 43 and 44 are currently pending.

¹ Due to the absence of claim 22 in the application as originally filed, claims 23-71 have been renumbered to claims 22-70, respectively. See Office Action, page 2.

Claims 1-42. (Cancelled)

43. (Currently Amended) [The system as recited in claim 39] A system for authoring and retrieving selected digital multimedia information relevant to a physical world, comprising:

a plurality of machine readable labels relevant to the physical world;

an apparatus for detecting the machine readable labels and including programming for normalizing information contained in the detected label into an object identifier; and

a digital multimedia library accessible by the apparatus storing content indexed by the object identifiers,

wherein the physical world comprises labeled locations containing labeled mobile objects.

44. (Currently Amended) The system as recited in claim [44] 43, wherein the labeled locations are used to determine proximity of the labeled mobile objects.

45-70. (Cancelled)

REMARKS

Claims 43 and 44 are pending. Applicants respectfully request that the Examiner reconsider all rejections in the outstanding Office Action in view of the foregoing amendments and the following remarks.

1. Claims 1-42 and 45-70

Claims 1-42 and 45-70 have been cancelled. Accordingly, all rejections in the instant application with respect to these claims are rendered moot.

Applicants note that these claims are solely conceived by Mr. Ajit Rajasekharan and are therefore being pursued in related U.S. Patent Application No. 09/987,597, which correctly identifies Mr. Rajasekharan as the sole inventor.

2. 35 U.S.C. § 103

Claims 43 and 44 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered unpatentable over U.S. Patent No. 5,480,306 to Liu in view of U.S. Patent No. 6,111,567 to Savchenko, and further in view of U.S. Patent No. 4,037,302 to Hollander and U.S. Patent No. 4,654,727 to Blum. Office Action, page 13. The Examiner concludes that Liu as modified by Savchenko fails to teach that the physical world comprises labeled locations containing labeled mobile objects and the labeled locations are used to determined proximity of the labeled mobile objects. *Id.* In an attempt to cure such a deficiency, Holland is introduced as teaching labeled locations, such as a labeled bin or labeled shelf.² *Id.* Applicants respectfully traverse this rejection on the following grounds.

In order to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143 (citations omitted). In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combinations. *See* M.P.E.P. §§ 2142 and 2143.01; *see also In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453,

² It appears that the Office Action does not rely on Blum with respect to claim 43.

1456 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.”). It is well-settled that an Examiner can “satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); *see also In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (“deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). As with rejections based on the combination of multiple references, “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence [of a motivation to combine]’” and thus do not support rejections based on combining references. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the “essence of hindsight” reconstruction, the very “syndrome” that the requirement for such evidence is designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 USPQ2d at 1617-18.

There is no showing of any objective teaching to combine Liu, Savchenko, and Hollander as applied to claim 43. The Office action merely states: “Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the teachings of Holland to the teachings of Liu as modified by Savchenko in order to identify the purpose, use or the physical description of the location of the labeled location so that the locations can easily and quickly [be] identified.” This broad, conclusory statement is not sufficient, under the controlling authorities set forth above, to justify combining the teachings of these three references. There is no showing that either of the applied references, or any other prior art, even remotely suggests such a combination. Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness.

Even assuming, *arguendo*, that a *prima facie* case of obviousness has been established, Liu, either taken alone or in combination with the secondary references, fails to teach or suggest all the limitations of claim 43.


For at least the reasons set forth above, Applicants respectfully submit that the instant rejection is improper and therefore, request that the Examiner withdraw the rejection of claims 43 and 44.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance, and such disposition is earnestly solicited. No fee is believed to be required for the entry of this response. Nevertheless, in the event that the U.S. Patent and Trademark Office requires a fee to enter this Response or to maintain the present application as pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

Dated: 5/21/03

By: 
Rodger L. Tate
Registration No. 27,399
(Representative for Mr. Rajasekharan)
Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, DC 20006-1109

Dated: _____

By: _____
Ognjan V. Shentov
Registration No. 38,051
(Representative for Ms. Kovesdi)
Pennie & Edmonds LLP
1155 Avenue of Americas
New York, N.Y. 10036-2711

September 15, 2003

Via Facsimile and Federal Express

(202) 778-2201

11326-003

Rodger L. Tate
HUNTON & WILLIAMS
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109

Re: United States Patent Application Serial No. 10/035,952
Filed: December 26, 2001
For: SYSTEM AND METHOD FOR AUTHORIZING
AND PROVIDING INFORMATION RELEVANT
TO A PHYSICAL WORLD
By: Kovesdi et al.

Dear Mr. Tate:

Enclosed is a copy of a response to the Office Action dated March 18, 2003 in the above mentioned application. We acknowledge receipt of your letters dated May 21, 2003 suggesting cancellation of several claims. The enclosed response takes into account Ms. Kovesdi's status as a coinventor in both the abovementioned patent application and the copending application that has been filed with insufficient authority to prosecute.

Please sign and return the enclosed response for filing with the Patent and Trademark Office without delay. Should you have any specific questions or suggestions, please do not hesitate in timely contacting us. In the event we do not hear from you, we will file the response with the Patent and Trademark Office to meet the response deadline.

Sincerely,



Rattan Nath

Enclosure

c: Ognjan Shentov, Esq.

TELEFACSIMILE LETTER
FROM
PENNIE AND EDMONDS
1155 Avenue of the Americas
New York, NY 10036
Telephone Number (212) 790-9090
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URGENT

TO: HUNTON & WILLIAMS
1900 K Street, N. W., Suite 1200
Washington, D.C. 20006-1109

Attention: Rodger L. Tate

FAX NO.: 1-202-778-2201

FROM: Rattan Nath

PAGES: 23

DATE: September 15, 2003

Application of: Kovesdi et al.

Serial No. 10/035,952

Filed: December 26, 2001

Transmitted herewith is the response to the Office Action of March 18, 2003

If you have any problem with your reception, please telephone the sender
at (212) 790-6536.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Kovesdi et al.	Confirmation No.:	3522
Serial No.:	10/035,952	Art Unit:	2876
Filed:	December 26, 2001	Examiner:	K. Koyama
For:	SYSTEM AND METHOD FOR AUTHORING AND PROVIDING INFORMATION RELEVANT TO A PHYSICAL WORLD	Attorney Docket No.:	11326-0003-999

RESPONSE AND AMENDMENT UNDER 37 C.F.R. § 1.111

Commissioner for Patents
PO BOX 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed March 18, 2003, and in accordance with the Rules of Practice, please enter the following amendments and consider the following remarks:

IN THE CLAIMS:

Applicants present all of the pending claims as indicated by the Office Action below. Claims 71-109 timely submitted in a preliminary amendment are not addressed by the Office Action, and are also not listed below. In addition, listed claims that were renumbered by the Examiner (presumably including adjusting the respective dependencies) to correct a mistake in the numbering have been identified as being previously amended to solely indicate this fact. Applicants thank Examiner Koyama for the corrections.

Please amend claims 1, 8, 13, 15-16, 31, 36, and 59 with insertions indicated by underlined text and deletions by strikethroughs, to read as follows:

1. (Currently amended) A method for authoring information relevant to a physical world, comprising:
 - detecting with an authoring device a first label associated with a first object;
 - and triggering, in response to detecting, a system for authoring content;
 - wherein the content is to be unambiguously bound to the first object and is to be rendered on a playback device ~~during~~ in response to detection of the first label.
2. (Original) The method as recited in claim 1, wherein the system for authoring content is resident on the authoring device.
3. (Original) The method as recited in claim 1, wherein the authoring device and the playback device are integrated within a single apparatus.
4. (Original) The method as recited in claim 1, wherein the label is selected from a group consisting of a barcode label, a coordinate, a RFID tag, an IR tag, a time stamp, a text string, and a speech to text string.
5. (Original) The method as recited in claim 1, wherein the content is selected from a group consisting of audio, text, image, and video.
6. (Original) The method as recited in claim 1, wherein the content is a link to a live agent.
7. (Original) The method as recited in claim 1, further comprising the steps of detecting a second label associated with a second object; triggering, in response to detecting, the system for authoring content which is unambiguously bound to the

- second object; and aggregating the content bound to the first object and the second object into a tour.
8. (Currently amended) The method as recited in claim 1, further comprising the step of detecting a second label associated with the first object and normalizing the first label and the second label such that the content bound to the first object can rendered ~~during~~ in response to detection of either the first or second label in the playback mode.
 9. (Original) The method as recited in claim 1, further comprising the step of storing the content in non-volatile memory resident in the apparatus.
 10. (Original) The method as recited in claim 1, further comprising the step of uploading the content to a remote server.
 11. (Original) The method as recited in claim 10, wherein the step of uploading is performed via a wireless network.
 12. (Original) The method as recited in claim 10, wherein the step of uploading is performed via a wired network.
 13. (Currently amended) A computer-readable media having instructions for authoring information relevant to a physical world, the instructions performing steps comprising:
 - detecting a first label associated with a first object; and
 - triggering, in response to detecting, a system for authoring content to be unambiguously bound to the first object; wherein the content is to be rendered ~~during~~ in response to detection of the first label by a device in a playback mode.
 14. (Original) The computer-readable media as recited in claim 13, wherein the instructions perform the further steps of detecting a second label associated with a second object; triggering, in response to detecting, a system for authoring content to be unambiguously bound to the second object; and aggregating the content bound to the first object and the second object into a tour.
 15. (Currently amended) The computer-readable media as recited in claim 14, wherein the instructions perform the further step of detecting a second label associated with the first object and normalizing the first label and the second label

such that the content can rendered during in response to detection of either the first or second label by the device in the playback mode.

16. (Currently amended) A computer-readable media having instructions for authoring content to be associated with objects in a physical world, the instructions performing steps comprising:
 - normalizing a read object label associated with an object into an object identifier;
 - placing the object identifier into a database;
 - accepting content to be rendered when in response to the object label is being read in a playback mode; and
 - binding the content to the object identifier in the database.
17. (Original) The computer-readable media as recited in claim 16, wherein the instructions allow a plurality of different label types to be normalized to one object identifier.
18. (Original) A method for providing information relevant to a physical world, comprising: detecting with a device a label associated with an object; normalizing information contained in the detected label into an object identifier; using the object identifier to search a database to find content bound to the object identifier; and rendering the content.
19. (Original) The method as recited in claim 18, further comprising the step of retrieving the content bound to the object identifier from local memory in the apparatus.
20. (Original) The method as recited in claim 18, further comprising the step of retrieving the content bound to the object identifier from a remote server.
21. (Original) The method as recited in claim 18, wherein the content is selected from a group consisting of audio, text, image, and video.
22. (Previously amended) The method as recited in claim 18, wherein the label is selected from a group consisting of a barcode, a coordinate, an IR tag, a RFID tag, a timestamp, a text string, and a speech to text string.
23. (Previously amended) The method as recited in claim 18, wherein the content is a connection to a live agent.

24. (Previously amended) The method as recited in claim 18, further comprising the step of determining the current time and comparing the current time to the timestamp before rendering the content.
25. (Previously amended) The method as recited in claim 18, wherein the step of rendering the content comprises streaming the content from a remote server.
26. (Previously amended) The method as recited in claim 18, further comprising the steps of accepting annotations/feedback after the rendering of the content and binding the annotations/feedback to the object identifier.
27. (Previously amended) The method as recited in claim 26, further comprising the step of storing the annotations/feedback in local memory.
28. (Previously amended) The method as recited in claim 26, further comprising the step of storing the annotations/feedback in a remote memory.
29. (Previously amended) A computer-readable media having instructions for providing information relevant to a physical world, the instructions performing steps comprising:
 - detecting a label associated with an object;
 - normalizing information contained in the detected label into an object identifier;
 - using the object identifier to search a database to find content bound to the object identifier; and
 - rendering the content.
30. (Previously amended) The computer-readable media as recited in claim 29, wherein the content is selected from a group consisting of audio, text, and video.
31. (Currently amended) A method for providing information relevant to a physical world, comprising:
 - storing an object identifier indicative of a plurality of read labels associated with an object into a database; and
 - using the database to bind content to the object identifier and, accordingly, the object; whereby the content is renderable when in response to any one of the plurality of labels is being detected in a playback mode.

32. (Previously amended) The method as recited in claim 31, wherein at least one of the plurality of labels is custom created.
33. (Previously amended) The method as recited in claim 31, further comprising the step of attaching at least one of the plurality of labels to the object.
34. (Previously amended) The method as recited in claim 31, wherein the plurality of labels is selected from a group consisting of a barcode label, a coordinate, a RFID tag, an IR tag, a time stamp, and a text string.
35. (Previously amended) The method as recited in claim 31, further comprising the steps of detecting the plurality of labels.
36. (Currently amended) A method for providing information relevant to a physical world, comprising:
- associating one or more labels with each of a plurality of objects in a tour;
 - storing an object identifier indicative of the one or more labels associated with each of the plurality of object in the tour in a database;
 - authoring content relevant to each of the plurality of objects in the tour; and
 - binding the content to an object identifier in the database which corresponds to the relevant one of the plurality of objects in the tour whereby the content is renderable when in response to the label is being detected by a playback device without regard to the order in which the content was authored.
37. (Previously amended) The method as recited in claim 36, wherein the labels are selected from a group consisting of coordinates, barcode labels, RFID tags, IR tags, timestamps, and text.
38. (Previously amended) A system for authoring and retrieving selected digital multimedia information relevant to a physical world, comprising:
- a plurality of machine readable labels relevant to the physical world;
 - an apparatus for detecting the machine readable labels and including programming for normalizing information contained in the detected label into an object identifier; and
 - a digital multimedia library accessible by the apparatus storing content indexed by the object identifiers.

39. (Previously amended) The system as recited in claim 38, wherein the apparatus further comprises a system for authoring digital multimedia in response to detecting one of the plurality of labels which is to be stored within the digital multimedia library and unambiguously bound to the object identifier.
40. (Previously amended) The system as recited in claim 39, wherein the apparatus further comprises a system for rendering digital multimedia in response to detecting one of the plurality of labels, the digital multimedia rendered being the content unambiguously bound to the object identifier associated with a detected label.
41. (Previously amended) The system as recited in claim 40, wherein the digital multimedia library includes one or more of audio files, visual image files, text files, video files, XML files, hyperlink references, live agent connection links, programming code files, and configuration information files.
42. (Previously amended) The system as recited in claim 40, wherein the apparatus comprises programming that renders digital multimedia as a function of output capabilities of the apparatus.
43. (Previously amended) The system as recited in claim 38, wherein the physical world comprises labeled locations containing labeled mobile objects.
44. (Previously amended) The system as recited in claim 43, wherein the labeled locations are used to determine proximity of the labeled mobile objects.
45. (Previously amended) The system as recited in claim 38, wherein the digital multimedia library is stored on one or more computer servers external to the apparatus.
46. (Previously amended) The system as recited in claim 45, wherein the digital multimedia library and the apparatus communicate via a wired network.
47. (Previously amended) The system as recited in claim 45, wherein the digital multimedia library and the apparatus communicate via a wireless network.
48. (Previously amended) The system as recited in claim 47, wherein the wireless network comprises a cellular telephone network.
49. (Previously amended) The system as recited in claim 38, wherein the digital multimedia library resides on the apparatus.

50. (Previously amended) The system as recited in claim 38, wherein the apparatus accesses the digital multimedia library via the Internet.
51. (Previously amended) The system as recited in claim 38, wherein the apparatus accesses the digital multimedia library via a voice portal.
52. (Previously amended) The system as recited in claim 38, wherein the apparatus accesses the digital multimedia library via a cellular telephone voice mailbox.
53. (Previously amended) The system as recited in claim 38, wherein the digital multimedia is aggregated into a tour.
54. (Previously amended) The system as recited in claim 38, wherein the digital multimedia is randomly accessible by the apparatus.
55. (Previously amended) The system as recited in claim 38, wherein the digital multimedia is accessible by the apparatus in a sequential order.
56. (Previously amended) The system as recited in claim 38, wherein the apparatus comprises a personal digital assistant.
57. (Previously amended) The system as recited in claim 38, wherein the apparatus comprises a cellular telephone.
58. (Previously amended) The system as recited in claim 38, wherein the apparatus comprises purpose built devices targeted to a specific application.
59. (Currently amended) An apparatus for authoring information relevant to a physical world, comprising:
 - circuitry for detecting a label associated with an object; and
 - a system for authoring content to be unambiguously bound to the object as represented by the detected label which content is to be rendered during in response to detection of the label in a playback mode.
60. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises a barcode reader.
61. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises an IR tag reader.

62. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises a RFID tag reader.
63. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises a keyboard for inputting textual information.
64. (Previously amended) An apparatus for authoring and providing information relevant to a physical world, comprising:
- circuitry for detecting a label associated with an object, and programming for normalizing information contained in the detected label into an object identifier;
 - a system for authoring content in an authoring mode which content is to be unambiguously bound to the object identifier; and
 - a system for rendering content in a playback mode, the content rendered being the content unambiguously bound to the object identifier associated with a detected label.
65. (Previously amended) The apparatus as recited in claim 64, further comprising a communications link for downloading authored content to a remote location and for retrieving content from the remote location for rendering.
66. (Previously amended) The apparatus as recited in claim 64, further comprising a memory for storing the content.
67. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry comprises a barcode reader.
68. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry comprises an IR tag reader.
69. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry determines a coordinate location.
70. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry is a RFID tag reader.

REMARKS

Applicants apologize for the mistake in numbering of the claims. The correction by the Examiner is gratefully acknowledged.

Applicants note that a preliminary amendment was filed on January 15, 2002 in this application, and the return postcard indicated it was received by the Patent and Trademark Office on February 27, 2002. This amendment submitted claims numbered as 72-110, which in view of the objections to the numbering should be 71-109. Thus, given the early date at which the preliminary amendment was filed, there should be claims 1-109 pending in the case instead of merely claims 1-70.

The Office Action has rejected all of the pending claims in the above-referenced application under 35 U.S.C. §§ 102(b) and 103(a). In addition, the Office Action has made a statutory type provisional double patenting rejection of claims 1-31, 33-42, and 45-70 claim the same invention as claims 1-70 of the copending patent application 09/987,597 ("the copending application").

The rejections under 35 U.S.C. §§ 102(b) and 103(a) are based on United States Patent No. 5,480,306 issued to Chih-Yuan Liu ("Liu") either alone or in combination with other United States Patents. These other patents include: U.S. Patent No. 6,111,567 issued to Savchenko et al. ("Savchenko"); U.S. Patent No. 5,958,014 issued to Ellis K. Cave ("Cave"); U.S. Patent No. 6,434,745 issued to Conley et al. ("Conley"); U.S. Patent No. 4,963,719 issued to Brooks et al. ("Brooks"); U.S. Patent No. 5,616,876 issued to Jonathan C. Cluts ("Cluts"); U.S. Patent No. 6,264,106 issued to Raj Bridgelall ("Bridgelall"); U.S. Patent No. 6,324,165 issued to Fan et al. ("Fan"); U.S. Patent No. 5,566,291 issued to Boulton ("Boulton"); U.S. Patent No. 6,195,531 issued to Aguirre ("Aguirre"); U.S. Patent No. 6,359,711 issued to Cole ("Cole"); U.S. Patent No. 5,598,540 issued to Steven D. Krueger ("Krueger"); U.S. Patent No. 6,315,195 issued to Natarajan Ramachandran ("Ramachandran"), U.S. Patent No. 5,869,820 issued to Chen et al. ("Chen"), U.S. Patent No. 6,095,418 issued to Schwartz et al. ("Schwartz"), U.S. Patent No. 4,037,302 issued to Hollander ("Hollander"), U.S. Patent No. 4,654,727 issued to Blum ("Blum") and U.S. Patent No. 5,613,137 issued to Bertram et al. ("Bertram").

Applicants respectfully disagree with the rejections for reasons set forth below. Applicants note that in the course of making the various rejections, the Office Action has also conceded that the cited references do not teach many of the claimed

features, which are discussed further. These missing features render the relied upon combinations of references insufficient, and when evaluated together with the lack of motivation insufficient for making obvious the claimed invention. Therefore, it is respectfully requested that all of the rejections be withdrawn and the application allowed to issue without delay.

PROVISIONAL STATUTORY DOUBLE PATENTING REJECTIONS

The Office Action states that claims 1-31, 33-42, and 45-70 of this application claim the same invention as claims 1-70 of the copending application. Applicants wish to alert the Examiner that a petition has been filed by one of the co-inventors in this case (by inventor Kovesdi on April 21, 2003) claiming co-inventorship in the copending application and requesting relief including change in inventorship in the copending application. An information disclosure statement filed in the copending application on April 21, 2003 also points out that there is insufficient authority to prosecute the copending application due to its failure to name the true inventors.

Applicants have amended independent claim 1 to distinguish it from the invention claimed in the copending application. Pending claim 1 following the entry of the amendment to claim 1 is distinct from the corresponding claim 1 since it no longer requires rendering of content "during" detection of the label and instead recites that the rendering of content is "in response to" the detection of the label. Thus, the rendering is necessarily after the detection of the label. Support for the amendment to claim 1 is found, for instance, in Figure 9. The description corresponding to the illustrative Figure 9 in paragraph 99 of the present application reads "cellular-phone 902 . . . decodes the GPS coordinates [] and sends the coordinates . . . to a remote server platform 918 [, which] . . . transforms the location coordinates into an object identifier, looks up the content associated with the object identifier, and sends back the information . . . to phone handset 902." Thus, even the object identifier is deduced prior to sending back of the information rather than while the label is being detected.

Applicants submit the amended claim 1 and all claims dependent upon it do not claim the invention of the corresponding claim 1 in the copending application, and respectfully request that the provisional double patenting rejection with respect to claim 1 and claims 2-12 dependent upon it be withdrawn.

Applicants have made similar amendments in independent claims 13, 16, 31, 36 and 59, which likewise do not claim the same invention as any of the corresponding claims in the copending application. Accordingly, applicants respectfully request that the provisional double patenting rejection of claims 8, 13-17, 31, 33-37, and 59-63 be withdrawn. In addition, applicants request that the

provisional rejections of the remaining claims be addressed upon allowance of the claims.

Applicants further note that notwithstanding these amendments, the subject matter of the originally filed claims may be pursued by the applicants in subsequent proceedings. In other words, the amendments are without prejudice.

OVERCOMING REJECTIONS UNDER 35 U.S.C. 102(B)

The Office Action has rejected claims 18, 19, 21, 22, 31, 34, 38, 54, and 58 under 35 U.S.C. § 102(b) for allegedly being anticipated by the Liu patent, which was cited by the applicants themselves. Of these rejected claims, claims 18, 31 and 38 are independent. For the sake of economy, Applicants have discussed only the rejections of the independent claims in detail since the limitations present in the independent claims (and missing from the disclosure of Liu) are also necessarily present in their respective dependent claims.

As to claim 18, Liu does not teach the detection of a label ‘associated with an object’ as is required and instead discloses detection of a label associated with content such as sounds. Not surprisingly, there is no teaching, disclosure or suggestion of using its content rendering identifiers to label objects such as the slides cited by the Office Action. Thus, the subsequent rendering of content bound to the object or an object identifier described in claim 18 is not disclosed or suggested by Liu.

The Office Action suggests that the printing of codes on slides or visible media provides the required object. However, the printed code of Liu in no way labels the object, and is instead only labeling the rendering of content according to Liu itself. Typically, multiple labels would be required for representing arbitrary content, with the number and nature of labels dependent upon the particular content to be rendered rather than the object. Liu does not even suggest that the code is useful for identifying the object it is printed upon. Nor is such a function inherent since the code is by its very design unrelated to the particular object it is printed upon. See figures 2-4 of Liu. Indeed, the distinct recitation of content and object in claim 18 are meaningless in the context of Liu, since Liu only discloses content rendering identifiers rather than object identifiers, and thus teaches away from the claimed invention. This distinction is also noted in the specification of the present application in paragraph 12, which explains that Liu requires defining an assignment between codes and words and sentences (instead of physical objects/locations/events and the like). Therefore, the rejection of claim 18 and claims 19, 21, 22 dependent upon it should be withdrawn.

The reasons set forth above with respect to claim 18 also apply to independent claim 31, which clearly recites “using the database to bind content to the object identifier.” There is no such association or database in Liu nor are there any object

identifiers. Therefore, the rejection of claims 31 and 34 (dependent upon claim 31) should be withdrawn.

Claim 38 recites “a plurality of machine readable labels relevant to the physical world” in describing the association between physical objects, locations, and/or temporal events and object identifiers. Clearly, in light of the prior discussion, Liu fails to disclose or suggest such an association. Therefore, the rejection of claim 38 and claims 54, and 58 (dependent upon claim 38) should be withdrawn.

OVERCOMING REJECTIONS UNDER 35 U.S.C. 103(a)

All of the obviousness based rejections rely upon at least the Liu reference, which is already shown to be insufficient to anticipate any of the pending claims. In addition to the limitations discussed previously, the Office Action itself makes the several observations regarding the deficiencies in the prior art in the course of its exhaustive and thorough examination. At least the following features of the claimed invention are also not disclosed according to the Office Action in the various combinations of the references:

1. Liu fails to teach a method for authoring information and a system for authoring the content.
2. Liu, even as modified by Savchenko, still fails to teach content is a link to a live agent.
3. Liu, even as modified by Savchenko, still fails to teach aggregating content into a single entity – the ‘tour.’
4. Liu, even as modified by Savchenko, still fails to teach detecting a second label associated with the first object and normalizing the first and second label such that content bound to the first object can be rendered during (or in response to) detection of either the first or second label in the playback mode.
5. Liu, even as modified by Savchenko, still fails to teach a step of uploading and downloading content to a remote server.
6. Liu, even as modified by Savchenko, still fails to teach that uploading is performed via a wireless network.
7. Liu fails to teach that rendering the content comprises streaming the content from a remote server.
8. Liu, even as modified by Savchenko, fails to teach a remote server
9. Liu, even as modified by Savchenko, still fails to teach that instructions allow a plurality of different label types to be normalized to one object identifier.
10. Liu fails to teach determining current time and comparing current time to the time stamp prior to rendering content.
11. Liu fails to teach accepting annotations/feedback after rendering of the content and binding the annotations/feedback to the object identifier.
12. Liu, even as modified by Boulton, fails to teach storing the annotations/feedback in a remote memory.
13. Liu fails to teach that at least one of the labels is custom created.
14. Liu, even as modified by Savchenko, still fails to teach that the physical world comprises labeled locations containing labeled objects, proximity of which may be determined by the labeled locations.
15. Liu, in combination with Savchenko and Cluts, still fails to teach that the wireless network comprises cellular telephone network.
16. Liu fails to disclose that the apparatus accesses the tour via the Internet and a voice portal.
17. Liu fails to teach accessing the tour via a cellular telephone voice mailbox.
18. Liu fails to teach that digital multimedia is accessible by the apparatus in a sequential order.
19. Liu fails to teach that the apparatus comprises a personal digital assistant and a cellular telephone.

20. Liu, even as modified by Savchenko, still fails to teach that the circuitry comprises an IR tag reader.
21. Liu, even as modified by Savchenko, still fails to teach a circuitry for determining a coordinate location.

These conclusions of the Office Action are in addition to the demonstration by applicants that Liu does not teach or suggest associating physical objects, events, locations and the like with labels, and instead associates labels with content alone. Since all of the independent claims recite labels associated with an object (rather than content), this additional drawback of Liu is relevant to the rejection of all of the claims. Thus, Liu is wholly unsuitable for rejecting any of the claims. Because this deficiency of Liu is not only not cured by any of the other cited references, it also removes the motivation, if any, for combining the various references with Liu. Such a motivation is required for making and maintaining an obviousness based rejection for each and every one of the eighteen different obviousness based rejections (paragraphs 5 and 7-24) in the Office Action.

As is well established, the motivation to combine should be found within the record and care needs to be exercised to avoid combinations of references that are based on hindsight. The absence of object identifiers in Liu, and in Savchenko is inconsistent with the proffered motivation for generating the various combinations.

For instance, in the context of the pending claim 1, and in light of the prior discussion, Liu does not disclose unambiguous binding of content to an object by the very nature of Liu's disclosure. This is so since it is the content that is labeled in Liu, see, e.g., column 2, lines 25-35, rather than the object. As a result, at best Liu discloses content rendering identifiers at best instead of object identifiers.

Savchenko does not provide the missing object identifiers either. Therefore all rejections based on the combination of at least Liu with Savchenko should be withdrawn. Accordingly, the rejections of claims 1-5, 9, 13, 16, 29, 30, 39-42, 59, 60, 63-64, and 66-67 should be withdrawn.

Similarly, Cave also fails to provide a motivation to combine it with Liu and Savchenko. Therefore the rejection of claims 6 and 23 should be withdrawn.

Since Liu and Savchenko do not disclose object identifiers, there is no motivation to combine them with Conley. Therefore, the rejection of claims 7, 14, 36, 37, 49, and 53 should be withdrawn.

The failure of Liu and Savchenko to use object identifiers makes their combination with Brooks artificial and driven by pure hindsight. Therefore, the rejection of claims 8, 15, 33, and 35 should be withdrawn.

Since neither Liu and Savchenko, alone or in combination, use object identifiers, nor does Cluts provide object identifiers and a motivation to combine them, the rejection of claims 10, 11, 12, 20, 25, 45-47 and 65 should be withdrawn. The failure of Boulton to provide the necessary motivation further requires that the rejection of claims 26-28 be withdrawn. In addition, the teaching of a cellular telephone network by Aguirre is insufficient to provide the required motivation. Therefore, the rejection of claim 48 should also be withdrawn.

Similarly, Bridgelall also is insufficient to provide a motivation to combine it with Liu and/or Savchenko. Therefore, the rejection of claims 17, 62, and 70 should be withdrawn.

The teaching of a timer by Fan is also insufficient to provide the necessary motivation to combine it with Liu. Therefore, the rejection of claim 24 should be withdrawn.

Not only do Liu and Savchenko fail to teach that the physical world comprises labeled locations containing labeled objects, they do not use object identifiers. Therefore, there is no motivation to combine them with Hollander and/or Blum. Therefore, the rejection of claims 43 and 44 should be withdrawn.

Likewise, Cole's teaching of voice mail and Internet fails to provide the motivation to combine it with Liu. Cole is also insufficient to provide the motivation to combine Aguirre with Liu. Thus, the rejection of claims 50-52 should be withdrawn.

The sequential storage of data taught by Krueger is insufficient motivation to combine it with Liu. Therefore, the rejection of claim 55 should be withdrawn. The portable terminal of Ramachandran that reads bar codes is also not sufficient to maintain the rejection of claim 56 and 57.

Chen's teaching of an infrared tag reader is similarly insufficient to provide the motivation to combine it with Liu and/or Savchenko, thus requiring the withdrawal of the rejection of claims 61 and 68.

The touchpad location determining circuitry of Bertram is likewise insufficient to provide the motivation to combine Bertram with Liu and/or Savchenko. Therefore, the rejection of claim 69 should be withdrawn.

There is no motivation to combine Schwartz with Liu since Liu lacks any teaching of object identifiers. Therefore, the rejection of claim 32 should be withdrawn as well.

Taken together, in view of the preceding discussion, all of the obviousness based rejections of claims 1-17, 20, 23-30, 32, 33, 35-37, 39-53, 55-57, and 59-70 under 35 U.S.C. § 103(a) should be withdrawn.

MISCELLANEOUS MATTERS

Applicants note that claims, filed numbered as 72-110, were submitted in a preliminary amendment filed on January 15, 2002, which have not been examined or entered.

Receipt of the January 15, 2002 preliminary amendment by the Patent Office is acknowledged by the PTO stamp on the self addressed postcard, a copy of which is attached. For the Examiner's convenience, applicants are attaching a copy of the preliminary amendment along with proof of its receipt by the PTO. In view of this, it is respectfully requested that the previously submitted claims also be entered and examined and that applicants be given a chance to respond to a first Office Action relating to them. Applicants note that the numbering of the claims needs to be corrected as being 71-109. Applicants will provide a more complete list of the renumbered pending claims upon the entry of the preliminary amendment.

CONCLUSION

Following the entry of this response and claim amendments herein all of the pending claims 1-109 are placed in form for allowance, although only claims 1-70 have been subject to examination. No new matter has been introduced by way of any of the amendments to the claims or the specification. Applicants respectfully request that they be allowed to proceed to issuance without delay.

No fee is estimated to be required for this submission other than the fee for the accompanying Petition for Extension of Time of three (3) months. Please charge any required fee to Deposit Account No. 16-1150.

Respectfully submitted,

Date September 15, 2003

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CONCLUSION

Following the entry of this response and claim amendments herein all of the pending claims 1-109 are placed in form for allowance, although only claims 1-70 have been subject to examination. No new matter has been introduced by way of any of the amendments to the claims or the specification. Applicants respectfully request that they be allowed to proceed to issuance without delay.

No fee is estimated to be required for this submission other than the fee for the accompanying Petition for Extension of Time of three (3) months. Please charge any required fee to Deposit Account No. 16-1150.

Date September 15, 2003

Respectfully submitted,



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Kovesdi et al.	Confirmation No.:	3522
Serial No.:	10/035,952	Art Unit:	2876
Filed:	December 26, 2001	Examiner:	K. Koyama
For:	SYSTEM AND METHOD FOR AUTHORING AND PROVIDING INFORMATION RELEVANT TO A PHYSICAL WORLD	Attorney Docket No.:	11326-0003-999

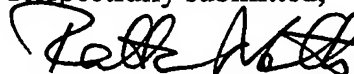
PETITION FOR EXTENSION OF TIME UNDER 37 CFR § 1.136(a)

Commissioner for Patents
PO BOX 1450
Alexandria, VA 22313-1450
Sir:

It is respectfully requested that the time for response to the Notice of Missing Parts of Nonprovisional Application mailed March 18, 2003 be extended for a period of Three months(3) from June 18, 2003 to and including September 19, 2003, since the Office was closed on September 18, 2003.

The fee for this extension is estimated to be \$465.00. Please charge the required fee to Pennie & Edmonds LLP Deposit Account No. 16-1150. A copy of this sheet is enclosed.

Respectfully submitted,



Date September 18, 2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Filed:	December 26, 2001	Examiner:	K. Koyama
For:	SYSTEM AND METHOD FOR AUTHORING AND PROVIDING INFORMATION RELEVANT TO A PHYSICAL WORLD	Attorney Docket No.:	11326-0003-999

RESPONSE AND AMENDMENT UNDER 37 C.F.R. § 1.111

Commissioner for Patents
PO BOX 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed March 18, 2003, and in accordance with the Rules of Practice, please enter the following amendments and consider the following remarks:

IN THE CLAIMS:

Applicants present all of the pending claims as indicated by the Office Action below. Claims 71-109 timely submitted in a preliminary amendment are not addressed by the Office Action, and are also not listed below. In addition, listed claims that were renumbered by the Examiner (presumably including adjusting the respective dependencies) to correct a mistake in the numbering have been identified as being previously amended to solely indicate this fact. Applicants thank Examiner Koyama for the corrections.

Please amend claims 1, 8, 13, 15-16, 31, 36, and 59 with insertions indicated by underlined text and deletions by strikethroughs, to read as follows:

1. (Currently amended) A method for authoring information relevant to a physical world, comprising:
 - detecting with an authoring device a first label associated with a first object;
 - and triggering, in response to detecting, a system for authoring content;
 - wherein the content is to be unambiguously bound to the first object and is to be rendered on a playback device during in response to detection of the first label.
2. (Original) The method as recited in claim 1, wherein the system for authoring content is resident on the authoring device.
3. (Original) The method as recited in claim 1, wherein the authoring device and the playback device are integrated within a single apparatus.
4. (Original) The method as recited in claim 1, wherein the label is selected from a group consisting of a barcode label, a coordinate, a RFID tag, an IR tag, a time stamp, a text string, and a speech to text string.
5. (Original) The method as recited in claim 1, wherein the content is selected from a group consisting of audio, text, image, and video.
6. (Original) The method as recited in claim 1, wherein the content is a link to a live agent.
7. (Original) The method as recited in claim 1, further comprising the steps of detecting a second label associated with a second object; triggering, in response to detecting, the system for authoring content which is unambiguously bound to the

second object; and aggregating the content bound to the first object and the second object into a tour.

8. (Currently amended) The method as recited in claim 1, further comprising the step of detecting a second label associated with the first object and normalizing the first label and the second label such that the content bound to the first object can rendered during in response to detection of either the first or second label in the playback mode.
9. (Original) The method as recited in claim 1, further comprising the step of storing the content in non-volatile memory resident in the apparatus.
10. (Original) The method as recited in claim 1, further comprising the step of uploading the content to a remote server.
11. (Original) The method as recited in claim 10, wherein the step of uploading is performed via a wireless network.
12. (Original) The method as recited in claim 10, wherein the step of uploading is performed via a wired network.
13. (Currently amended) A computer-readable media having instructions for authoring information relevant to a physical world, the instructions performing steps comprising:
 - detecting a first label associated with a first object; and
 - triggering, in response to detecting, a system for authoring content to be unambiguously bound to the first object; wherein the content is to be rendered during in response to detection of the first label by a device in a playback mode.
14. (Original) The computer-readable media as recited in claim 13, wherein the instructions perform the further steps of detecting a second label associated with a second object; triggering, in response to detecting, a system for authoring content to be unambiguously bound to the second object; and aggregating the content bound to the first object and the second object into a tour.
15. (Currently amended) The computer-readable media as recited in claim 14, wherein the instructions perform the further step of detecting a second label associated with the first object and normalizing the first label and the second label

such that the content can rendered during in response to detection of either the first or second label by the device in the playback mode.

16. (Currently amended) A computer-readable media having instructions for authoring content to be associated with objects in a physical world, the instructions performing steps comprising:
 - normalizing a read object label associated with an object into an object identifier;
 - placing the object identifier into a database;
 - accepting content to be rendered ~~when~~ in response to the object label is being read in a playback mode; and
 - binding the content to the object identifier in the database.
17. (Original) The computer-readable media as recited in claim 16, wherein the instructions allow a plurality of different label types to be normalized to one object identifier.
18. (Original) A method for providing information relevant to a physical world, comprising: detecting with a device a label associated with an object; normalizing information contained in the detected label into an object identifier; using the object identifier to search a database to find content bound to the object identifier; and rendering the content.
19. (Original) The method as recited in claim 18, further comprising the step of retrieving the content bound to the object identifier from local memory in the apparatus.
20. (Original) The method as recited in claim 18, further comprising the step of retrieving the content bound to the object identifier from a remote server.
21. (Original) The method as recited in claim 18, wherein the content is selected from a group consisting of audio, text, image, and video.
22. (Previously amended) The method as recited in claim 18, wherein the label is selected from a group consisting of a barcode, a coordinate, an IR tag, a RFID tag, a timestamp, a text string, and a speech to text string.
23. (Previously amended) The method as recited in claim 18, wherein the content is a connection to a live agent.

24. (Previously amended) The method as recited in claim 18, further comprising the step of determining the current time and comparing the current time to the timestamp before rendering the content.
25. (Previously amended) The method as recited in claim 18, wherein the step of rendering the content comprises streaming the content from a remote server.
26. (Previously amended) The method as recited in claim 18, further comprising the steps of accepting annotations/feedback after the rendering of the content and binding the annotations/feedback to the object identifier.
27. (Previously amended) The method as recited in claim 26, further comprising the step of storing the annotations/feedback in local memory.
28. (Previously amended) The method as recited in claim 26, further comprising the step of storing the annotations/feedback in a remote memory.
29. (Previously amended) A computer-readable media having instructions for providing information relevant to a physical world, the instructions performing steps comprising:
- detecting a label associated with an object;
 - normalizing information contained in the detected label into an object identifier;
 - using the object identifier to search a database to find content bound to the object identifier; and
 - rendering the content.
30. (Previously amended) The computer-readable media as recited in claim 29, wherein the content is selected from a group consisting of audio, text, and video.
31. (Currently amended) A method for providing information relevant to a physical world, comprising:
- storing an object identifier indicative of a plurality of read labels associated with an object into a database; and
 - using the database to bind content to the object identifier and, accordingly, the object; whereby the content is renderable ~~when~~ in response to any one of the plurality of labels is being detected in a playback mode.

32. (Previously amended) The method as recited in claim 31, wherein at least one of the plurality of labels is custom created.
33. (Previously amended) The method as recited in claim 31, further comprising the step of attaching at least one of the plurality of labels to the object.
34. (Previously amended) The method as recited in claim 31, wherein the plurality of labels is selected from a group consisting of a barcode label, a coordinate, a RFID tag, an IR tag, a time stamp, and a text string.
35. (Previously amended) The method as recited in claim 31, further comprising the steps of detecting the plurality of labels.
36. (Currently amended) A method for providing information relevant to a physical world, comprising:
- associating one or more labels with each of a plurality of objects in a tour;
 - storing an object identifier indicative of the one or more labels associated with each of the plurality of objects in the tour in a database;
 - authoring content relevant to each of the plurality of objects in the tour; and
 - binding the content to an object identifier in the database which corresponds to the relevant one of the plurality of objects in the tour whereby the content is renderable when in response to the label is being detected by a playback device without regard to the order in which the content was authored.
37. (Previously amended) The method as recited in claim 36, wherein the labels are selected from a group consisting of coordinates, barcode labels, RFID tags, IR tags, timestamps, and text.
38. (Previously amended) A system for authoring and retrieving selected digital multimedia information relevant to a physical world, comprising:
- a plurality of machine readable labels relevant to the physical world;
 - an apparatus for detecting the machine readable labels and including programming for normalizing information contained in the detected label into an object identifier; and
 - a digital multimedia library accessible by the apparatus storing content indexed by the object identifiers.

39. (Previously amended) The system as recited in claim 38, wherein the apparatus further comprises a system for authoring digital multimedia in response to detecting one of the plurality of labels which is to be stored within the digital multimedia library and unambiguously bound to the object identifier.
40. (Previously amended) The system as recited in claim 39, wherein the apparatus further comprises a system for rendering digital multimedia in response to detecting one of the plurality of labels, the digital multimedia rendered being the content unambiguously bound to the object identifier associated with a detected label.
41. (Previously amended) The system as recited in claim 40, wherein the digital multimedia library includes one or more of audio files, visual image files, text files, video files, XML files, hyperlink references, live agent connection links, programming code files, and configuration information files.
42. (Previously amended) The system as recited in claim 40, wherein the apparatus comprises programming that renders digital multimedia as a function of output capabilities of the apparatus.
43. (Previously amended) The system as recited in claim 38, wherein the physical world comprises labeled locations containing labeled mobile objects.
44. (Previously amended) The system as recited in claim 43, wherein the labeled locations are used to determine proximity of the labeled mobile objects.
45. (Previously amended) The system as recited in claim 38, wherein the digital multimedia library is stored on one or more computer servers external to the apparatus.
46. (Previously amended) The system as recited in claim 45, wherein the digital multimedia library and the apparatus communicate via a wired network.
47. (Previously amended) The system as recited in claim 45, wherein the digital multimedia library and the apparatus communicate via a wireless network.
48. (Previously amended) The system as recited in claim 47, wherein the wireless network comprises a cellular telephone network.
49. (Previously amended) The system as recited in claim 38, wherein the digital multimedia library resides on the apparatus.

50. (Previously amended) The system as recited in claim 38, wherein the apparatus accesses the digital multimedia library via the Internet.
51. (Previously amended) The system as recited in claim 38, wherein the apparatus accesses the digital multimedia library via a voice portal.
52. (Previously amended) The system as recited in claim 38, wherein the apparatus accesses the digital multimedia library via a cellular telephone voice mailbox.
53. (Previously amended) The system as recited in claim 38, wherein the digital multimedia is aggregated into a tour.
54. (Previously amended) The system as recited in claim 38, wherein the digital multimedia is randomly accessible by the apparatus.
55. (Previously amended) The system as recited in claim 38, wherein the digital multimedia is accessible by the apparatus in a sequential order.
56. (Previously amended) The system as recited in claim 38, wherein the apparatus comprises a personal digital assistant.
57. (Previously amended) The system as recited in claim 38, wherein the apparatus comprises a cellular telephone.
58. (Previously amended) The system as recited in claim 38, wherein the apparatus comprises purpose built devices targeted to a specific application.
59. (Currently amended) An apparatus for authoring information relevant to a physical world, comprising:
 - circuitry for detecting a label associated with an object; and
 - a system for authoring content to be unambiguously bound to the object as represented by the detected label which content is to be rendered during in response to detection of the label in a playback mode.
60. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises a barcode reader.
61. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises an IR tag reader.

62. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises a RFID tag reader.
63. (Previously amended) The apparatus as recited in claim 59, wherein the circuitry comprises a keyboard for inputting textual information.
64. (Previously amended) An apparatus for authoring and providing information relevant to a physical world, comprising:
- circuitry for detecting a label associated with an object, and programming for normalizing information contained in the detected label into an object identifier;
 - a system for authoring content in an authoring mode which content is to be unambiguously bound to the object identifier; and
 - a system for rendering content in a playback mode, the content rendered being the content unambiguously bound to the object identifier associated with a detected label.
65. (Previously amended) The apparatus as recited in claim 64, further comprising a communications link for downloading authored content to a remote location and for retrieving content from the remote location for rendering.
66. (Previously amended) The apparatus as recited in claim 64, further comprising a memory for storing the content.
67. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry comprises a barcode reader.
68. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry comprises an IR tag reader.
69. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry determines a coordinate location.
70. (Previously amended) The apparatus as recited in claim 64, wherein the circuitry is a RFID tag reader.

REMARKS

Applicants apologize for the mistake in numbering of the claims. The correction by the Examiner is gratefully acknowledged.

Applicants note that a preliminary amendment was filed on January 15, 2002 in this application, and the return postcard indicated it was received by the Patent and Trademark Office on February 27, 2002. This amendment submitted claims numbered as 72-110, which in view of the objections to the numbering should be 71-109. Thus, given the early date at which the preliminary amendment was filed, there should be claims 1-109 pending in the case instead of merely claims 1-70.

The Office Action has rejected all of the pending claims in the above-referenced application under 35 U.S.C. §§ 102(b) and 103(a). In addition, the Office Action has made a statutory type provisional double patenting rejection of claims 1-31, 33-42, and 45-70 claim the same invention as claims 1-70 of the copending patent application 09/987,597 ("the copending application").

The rejections under 35 U.S.C. §§ 102(b) and 103(a) are based on United States Patent No. 5,480,306 issued to Chih-Yuan Liu ("Liu") either alone or in combination with other United States Patents. These other patents include: U.S. Patent No. 6,111,567 issued to Savchenko et al. ("Savchenko"); U.S. Patent No. 5,958,014 issued to Ellis K. Cave ("Cave"); U.S. Patent No. 6,434,745 issued to Conley et al. ("Conley"); U.S. Patent No. 4,963,719 issued to Brooks et al. ("Brooks"); U.S. Patent No. 5,616,876 issued to Jonathan C. Cluts ("Cluts"); U.S. Patent No. 6,264,106 issued to Raj Bridgelall ("Bridgelall"); U.S. Patent No. 6,324,165 issued to Fan et al. ("Fan"); U.S. Patent No. 5,566,291 issued to Boulton ("Boulton"); U.S. Patent No. 6,195,531 issued to Aguirre ("Aguirre"); U.S. Patent No. 6,359,711 issued to Cole ("Cole"); U.S. Patent No. 5,598,540 issued to Steven D. Krueger ("Krueger"); U.S. Patent No. 6,315,195 issued to Natarajan Ramachandran ("Ramachandran"), U.S. Patent No. 5,869,820 issued to Chen et al. ("Chen"), U.S. Patent No. 6,095,418 issued to Schwartz et al. ("Schwartz"), U.S. Patent No. 4,037,302 issued to Hollander ("Hollander"), U.S. Patent No. 4,654,727 issued to Blum ("Blum") and U.S. Patent No. 5,613,137 issued to Bertram et al. ("Bertram").

Applicants respectfully disagree with the rejections for reasons set forth below. Applicants note that in the course of making the various rejections, the Office Action has also conceded that the cited references do not teach many of the claimed

features, which are discussed further. These missing features render the relied upon combinations of references insufficient, and when evaluated together with the lack of motivation insufficient for making obvious the claimed invention. Therefore, it is respectfully requested that all of the rejections be withdrawn and the application allowed to issue without delay.

PROVISIONAL STATUTORY DOUBLE PATENTING REJECTIONS

The Office Action states that claims 1-31, 33-42, and 45-70 of this application claim the same invention as claims 1-70 of the copending application. Applicants wish to alert the Examiner that a petition has been filed by one of the co-inventors in this case (by inventor Kovesdi on April 21, 2003) claiming co-inventorship in the copending application and requesting relief including change in inventorship in the copending application. An information disclosure statement filed in the copending application on April 21, 2003 also points out that there is insufficient authority to prosecute the copending application due to its failure to name the true inventors.

Applicants have amended independent claim 1 to distinguish it from the invention claimed in the copending application. Pending claim 1 following the entry of the amendment to claim 1 is distinct from the corresponding claim 1 since it no longer requires rendering of content “during” detection of the label and instead recites that the rendering of content is “in response to” the detection of the label. Thus, the rendering is necessarily after the detection of the label. Support for the amendment to claim 1 is found, for instance, in Figure 9. The description corresponding to the illustrative Figure 9 in paragraph 99 of the present application reads “cellular-phone 902 . . . decodes the GPS coordinates [] and sends the coordinates . . . to a remote server platform 918 [, which] . . . transforms the location coordinates into an object identifier, looks up the content associated with the object identifier, and sends back the information . . . to phone handset 902.” Thus, even the object identifier is deduced prior to sending back of the information rather than while the label is being detected.

Applicants submit the amended claim 1 and all claims dependent upon it do not claim the invention of the corresponding claim 1 in the copending application, and respectfully request that the provisional double patenting rejection with respect to claim 1 and claims 2-12 dependent upon it be withdrawn.

Applicants have made similar amendments in independent claims 13, 16, 31, 36 and 59, which likewise do not claim the same invention as any of the corresponding claims in the copending application. Accordingly, applicants respectfully request that the provisional double patenting rejection of claims 8, 13-17, 31, 33-37, and 59-63 be withdrawn. In addition, applicants request that the

provisional rejections of the remaining claims be addressed upon allowance of the claims.

Applicants further note that notwithstanding these amendments, the subject matter of the originally filed claims may be pursued by the applicants in subsequent proceedings. In other words, the amendments are without prejudice.

OVERCOMING REJECTIONS UNDER 35 U.S.C. 102(B)

The Office Action has rejected claims 18, 19, 21, 22, 31, 34, 38, 54, and 58 under 35 U.S.C. § 102(b) for allegedly being anticipated by the Liu patent, which was cited by the applicants themselves. Of these rejected claims, claims 18, 31 and 38 are independent. For the sake of economy, Applicants have discussed only the rejections of the independent claims in detail since the limitations present in the independent claims (and missing from the disclosure of Liu) are also necessarily present in their respective dependent claims.

As to claim 18, Liu does not teach the detection of a label ‘associated with an object’ as is required and instead discloses detection of a label associated with content such as sounds. Not surprisingly, there is no teaching, disclosure or suggestion of using its content rendering identifiers to label objects such as the slides cited by the Office Action. Thus, the subsequent rendering of content bound to the object or an object identifier described in claim 18 is not disclosed or suggested by Liu.

The Office Action suggests that the printing of codes on slides or visible media provides the required object. However, the printed code of Liu in no way labels the object, and is instead only labeling the rendering of content according to Liu itself. Typically, multiple labels would be required for representing arbitrary content, with the number and nature of labels dependent upon the particular content to be rendered rather than the object. Liu does not even suggest that the code is useful for identifying the object it is printed upon. Nor is such a function inherent since the code is by its very design unrelated to the particular object it is printed upon. See figures 2-4 of Liu. Indeed, the distinct recitation of content and object in claim 18 are meaningless in the context of Liu, since Liu only discloses content rendering identifiers rather than object identifiers, and thus teaches away from the claimed invention. This distinction is also noted in the specification of the present application in paragraph 12, which explains that Liu requires defining an assignment between codes and words and sentences (instead of physical objects/locations/events and the like). Therefore, the rejection of claim 18 and claims 19, 21, 22 dependent upon it should be withdrawn.

The reasons set forth above with respect to claim 18 also apply to independent claim 31, which clearly recites “using the database to bind content to the object identifier.” There is no such association or database in Liu nor are there any object

identifiers. Therefore, the rejection of claims 31 and 34 (dependent upon claim 31) should be withdrawn.

Claim 38 recites “a plurality of machine readable labels relevant to the physical world” in describing the association between physical objects, locations, and/or temporal events and object identifiers. Clearly, in light of the prior discussion, Liu fails to disclose or suggest such an association. Therefore, the rejection of claim 38 and claims 54, and 58 (dependent upon claim 38) should be withdrawn.

OVERCOMING REJECTIONS UNDER 35 U.S.C. 103(a)

All of the obviousness based rejections rely upon at least the Liu reference, which is already shown to be insufficient to anticipate any of the pending claims. In addition to the limitations discussed previously, the Office Action itself makes the several observations regarding the deficiencies in the prior art in the course of its exhaustive and thorough examination. At least the following features of the claimed invention are also not disclosed according to the Office Action in the various combinations of the references:

1. Liu fails to teach a method for authoring information and a system for authoring the content.
2. Liu, even as modified by Savchenko, still fails to teach content is a link to a live agent.
3. Liu, even as modified by Savchenko, still fails to teach aggregating content into a single entity – the ‘tour.’
4. Liu, even as modified by Savchenko, still fails to teach detecting a second label associated with the first object and normalizing the first and second label such that content bound to the first object can be rendered during (or in response to) detection of either the first or second label in the playback mode.
5. Liu, even as modified by Savchenko, still fails to teach a step of uploading and downloading content to a remote server.
6. Liu, even as modified by Savchenko, still fails to teach that uploading is performed via a wireless network.
7. Liu fails to teach that rendering the content comprises streaming the content from a remote server.
8. Liu, even as modified by Savchenko, fails to teach a remote server
9. Liu, even as modified by Savchenko, still fails to teach that instructions allow a plurality of different label types to be normalized to one object identifier.
10. Liu fails to teach determining current time and comparing current time to the time stamp prior to rendering content.
11. Liu fails to teach accepting annotations/feedback after rendering of the content and binding the annotations/feedback to the object identifier.
12. Liu, even as modified by Boulton, fails to teach storing the annotations/feedback in a remote memory.
13. Liu fails to teach that at least one of the labels is custom created.
14. Liu, even as modified by Savchenko, still fails to teach that the physical world comprises labeled locations containing labeled objects, proximity of which may be determined by the labeled locations.
15. Liu, in combination with Savchenko and Cluts, still fails to teach that the wireless network comprises cellular telephone network.
16. Liu fails to disclose that the apparatus accesses the tour via the Internet and a voice portal.
17. Liu fails to teach accessing the tour via a cellular telephone voice mailbox.
18. Liu fails to teach that digital multimedia is accessible by the apparatus in a sequential order.
19. Liu fails to teach that the apparatus comprises a personal digital assistant and a cellular telephone.

20. Liu, even as modified by Savchenko, still fails to teach that the circuitry comprises an IR tag reader.
21. Liu, even as modified by Savchenko, still fails to teach a circuitry for determining a coordinate location.

These conclusions of the Office Action are in addition to the demonstration by applicants that Liu does not teach or suggest associating physical objects, events, locations and the like with labels, and instead associates labels with content alone. Since all of the independent claims recite labels associated with an object (rather than content), this additional drawback of Liu is relevant to the rejection of all of the claims. Thus, Liu is wholly unsuitable for rejecting any of the claims. Because this deficiency of Liu is not only not cured by any of the other cited references, it also removes the motivation, if any, for combining the various references with Liu. Such a motivation is required for making and maintaining an obviousness based rejection for each and every one of the eighteen different obviousness based rejections (paragraphs 5 and 7-24) in the Office Action.

As is well established, the motivation to combine should be found within the record and care needs to be exercised to avoid combinations of references that are based on hindsight. The absence of object identifiers in Liu, and in Savchenko is inconsistent with the proffered motivation for generating the various combinations.

For instance, in the context of the pending claim 1, and in light of the prior discussion, Liu does not disclose unambiguous binding of content to an object by the very nature of Liu's disclosure. This is so since it is the content that is labeled in Liu, see, e.g., column 2, lines 25-35, rather than the object. As a result, at best Liu discloses content rendering identifiers at best instead of object identifiers.

Savchenko does not provide the missing object identifiers either. Therefore all rejections based on the combination of at least Liu with Savchenko should be withdrawn. Accordingly, the rejections of claims 1-5, 9, 13, 16, 29, 30, 39-42, 59, 60, 63-64, and 66-67 should be withdrawn.

Similarly, Cave also fails to provide a motivation to combine it with Liu and Savchenko. Therefore the rejection of claims 6 and 23 should be withdrawn.

Since Liu and Savchenko do not disclose object identifiers, there is no motivation to combine them with Conley. Therefore, the rejection of claims 7, 14, 36, 37, 49, and 53 should be withdrawn.

The failure of Liu and Savchenko to use object identifiers makes their combination with Brooks artificial and driven by pure hindsight. Therefore, the rejection of claims 8, 15, 33, and 35 should be withdrawn.

Since neither Liu and Savchenko, alone or in combination, use object identifiers, nor does Cluts provide object identifiers and a motivation to combine them, the rejection of claims 10, 11, 12, 20, 25, 45-47 and 65 should be withdrawn. The failure of Boulton to provide the necessary motivation further requires that the rejection of claims 26-28 be withdrawn. In addition, the teaching of a cellular telephone network by Aguirre is insufficient to provide the required motivation. Therefore, the rejection of claim 48 should also be withdrawn.

Similarly, Bridgelall also is insufficient to provide a motivation to combine it with Liu and/or Savchenko. Therefore, the rejection of claims 17, 62, and 70 should be withdrawn.

The teaching of a timer by Fan is also insufficient to provide the necessary motivation to combine it with Liu. Therefore, the rejection of claim 24 should be withdrawn.

Not only do Liu and Savchenko fail to teach that the physical world comprises labeled locations containing labeled objects, they do not use object identifiers. Therefore, there is no motivation to combine them with Hollander and/or Blum. Therefore, the rejection of claims 43 and 44 should be withdrawn.

Likewise, Cole's teaching of voice mail and Internet fails to provide the motivation to combine it with Liu. Cole is also insufficient to provide the motivation to combine Aguirre with Liu. Thus, the rejection of claims 50-52 should be withdrawn.

The sequential storage of data taught by Krueger is insufficient motivation to combine it with Liu. Therefore, the rejection of claim 55 should be withdrawn. The portable terminal of Ramachandran that reads bar codes is also not sufficient to maintain the rejection of claim 56 and 57.

Chen's teaching of an infrared tag reader is similarly insufficient to provide the motivation to combine it with Liu and/or Savchenko, thus requiring the withdrawal of the rejection of claims 61 and 68.

The touchpad location determining circuitry of Bertram is likewise insufficient to provide the motivation to combine Bertram with Liu and/or Savchenko. Therefore, the rejection of claim 69 should be withdrawn.

There is no motivation to combine Schwartz with Liu since Liu lacks any teaching of object identifiers. Therefore, the rejection of claim 32 should be withdrawn as well.

Taken together, in view of the preceding discussion, all of the obviousness based rejections of claims 1-17, 20, 23-30, 32, 33, 35-37, 39-53, 55-57, and 59-70 under 35 U.S.C. § 103(a) should be withdrawn.

MISCELLANEOUS MATTERS

Applicants note that claims, filed numbered as 72-110, were submitted in a preliminary amendment filed on January 15, 2002, which have not been examined or entered.

Receipt of the January 15, 2002 preliminary amendment by the Patent Office is acknowledged by the PTO stamp on the self addressed postcard, a copy of which is attached. For the Examiner's convenience, applicants are attaching a copy of the preliminary amendment along with proof of its receipt by the PTO. In view of this, it is respectfully requested that the previously submitted claims also be entered and examined and that applicants be given a chance to respond to a first Office Action relating to them. Applicants note that the numbering of the claims needs to be corrected as being 71-109. Applicants will provide a more complete list of the renumbered pending claims upon the entry of the preliminary amendment.

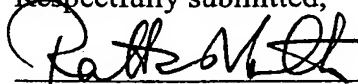
CONCLUSION

Following the entry of this response and claim amendments herein all of the pending claims 1-109 are placed in form for allowance, although only claims 1-70 have been subject to examination. No new matter has been introduced by way of any of the amendments to the claims or the specification. Applicants respectfully request that they be allowed to proceed to issuance without delay.

No fee is estimated to be required for this submission other than the fee for the accompanying Petition for Extension of Time of three (3) months. Please charge any required fee to Deposit Account No. 16-1150.

Date September 18, 2003

Respectfully submitted,



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Date September __, 2003

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(202) 955-1500

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Kovesdi et al.)	
)	Examiner: Not Assigned
Serial No.:	10/035,952)	
)	Art Unit: Not Assigned
Filed:	December 26, 2001)	
)	Atty Docket: 66566.01US2
Title:	System And Methods For)	
	Authoring And Providing)	
	Information Relevant To)	
	A Physical World)	

PRELIMINARY AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Please enter the following amendments and consider the following remarks.

IN THE CLAIMS

Please add the following new claims:

72. (New) The method as recited in claim 1, further comprising transforming the detected first label to a normalized alphanumeric string and using the normalized alphanumeric string as a uniform object identifier to index the content.

73. (New) The method as recited in claim 72, wherein the first label is a voice input.

74. (New) The method as recited in claim 4, wherein detecting the coordinate label further comprises using location detection circuitry.

75. (New) The method as recited in claim 4, wherein detecting the coordinate label further comprises using information provided by a cellular wireless network.

76. (New) The method as recited in claim 4, wherein detecting the coordinate label further comprises using information provided by a wireless local area network.

77. (New) The method as recited in claim 4, wherein detecting the coordinate label further comprises using information provided by a wireless personal area network.

78. (New) The method as recited in claim 4, wherein detecting the coordinate label further comprises using information provided by voice input.

79. (New) The method as recited in claim 7, further comprising restricting access to the tour.

80. (New) The method as recited in claim 7, further comprising publishing the tour on a publicly accessible network.

81. (New) The computer-readable media as recited in claim 13, wherein the first object is a person.

82. (New) The computer-readable media as recited in claim 13, wherein the first label is a location coordinate.

83. (New) The system as recited in claim 48, wherein the wireless network comprises a wireless local area network.

84. (New) The system as recited in claim 48, wherein the wireless network comprises a wireless personal area network.

85. (New) The system as recited in claim 55, wherein access to the digital multimedia is proactively initiated by a user of the apparatus.

86. (New) The system as recited in claim 55, wherein access to the digital multimedia is automatically triggered in response to detection of one of the plurality of labels.

87. (New) The system as recited in claim 55, wherein access to the digital multimedia is proactively initiated by a user of the apparatus in a foreground channel and access to the digital multimedia is automatically triggered in response to detection of one of the plurality of labels in a background channel.

88. (New) The system as recited in claim 39, wherein the content comprises information providing a physical object based tour.

89. (New) The system as recited in claim 39, wherein the content comprises information providing a location based tour.

90. (New) The system as recited in claim 39, wherein the content comprises information providing a timestamp based tour.
91. (New) The system as recited in claim 39, wherein the content comprises information providing a linearly sequenced tour.
92. (New) The system as recited in claim 39, wherein the content comprises information for providing an audio based tour.
93. (New) The system as recited in claim 39, wherein the content comprises information for providing a speaking and reading educational tour for children.
94. (New) The system as recited in claim 39, wherein the content comprises information for providing a tour of custom labeled household items.
95. (New) The system as recited in claim 39, further comprising a book in which is located the plurality of machine readable labels.
96. (New) The system as recited in 39, wherein the content comprises information cataloging objects in the physical world.
97. (New) The system as recited in claim 39, wherein the objects are located in a household.

98. (New) The system as recited in claim 39, wherein the objects are located in a retail establishment.
99. (New) The system as recited in claim 39, wherein each of the plurality of labels is worn by an individual.
100. (New) The system as recited in claim 39, wherein the content comprises a chronological record of speech utterances.
101. (New) The system as recited in claim 39, wherein the content comprises information for providing a tour of historical places.
102. (New) The system as recited in claim 39, wherein the content comprises verbal descriptions of objects in the real world in multiple languages.
103. (New) The system as recited in claim 39, wherein the content comprises information for providing a tour of a cemetery.
104. (New) The system as recited in claim 39, wherein the content comprises information for providing a tour of objects in an exhibition.
105. (New) The system as recited in claim 39, wherein the content comprises information authored by a plurality of individuals aggregated into a common tour.

106. (New) The system as recited in claim 39, wherein the content comprises information for providing a tour of a nature trail.

107. (New) The system as recited in claim 39, wherein the content comprises information for providing a tour of a park.

108. (New) The system as recited in claim 39, wherein access to the digital multimedia is by means of a unified messaging mailbox.

109. (New) The system as recited in claim 39, wherein the apparatus is adapted to provide visual or audio hints to the user as a function of proximity to the machine readable labels such that the system is usable in connection with a treasure hunting game.

110. (New) The method as recited in claim 73, wherein the voice input comprises a numeric value read from a barcode label.

REMARKS

The application is considered to be in good and proper form for allowance. Such action on the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

Respectfully submitted,

Date: January 15, 2002

By: _____

Gary R. Jarosik
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Alzheimer & Gray
10 South Wacker Drive, Suite 4000
Chicago, Illinois 60606
(312) 715-4522

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| <input type="checkbox"/> | Sections 8 & 15 Affidavit | <input type="checkbox"/> | Patent Maintenance Fee |
| <input type="checkbox"/> | | | |
| <input type="checkbox"/> | | | |

Client: *Rozsa Kovacs*
Mark: *System and Method for Authenticating*
Ser. No.: _____
Reg. No.: _____
Pat. No.: *10,035,952*
Atty. or Para.: *Gary R. Jarosik*
FORM # 114 1/5/02

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| <input type="checkbox"/> | |

Client: *Rozsa Kovessli*Mark: *System and method for authoring and providing info. . .*

Ser. No.: _____

Reg. No.: _____

Pat. No.: *10/035,952*Atty. or Para.: *Gary R. Jarosik*FORM # 114 *1/15/02*

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PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Application Number	10/035,952
Filing Date	12/26/2001
First Named Inventor	Rozsa Kovessi
Group Art Unit	not assigned
Examiner Name	not assigned
Attorney Docket Number	66566.01US2

Total Number of Pages in This Submission 9

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
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<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

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ALTHEIMER & GRAYBy: **SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual name	Customer No. 25541
Signature	By: Gary R. Jarosik
Date	January 15, 2002

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: 01/15/2002

Typed or printed name	Lisa Lyle	Date	01/15/2002
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FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$)351.00

Complete if Known

Application Number	10/035,952
Filing Date	December 26, 2001
First Named Inventor	Rozsa Kovessi
Examiner Name	
Group Art Unit	
Attorney Docket No.	66566.01US2

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
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1. BASIC FILING FEE

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101 740	201 370	Utility filing fee	
106 330	206 165	Design filing fee	
107 510	207 255	Plant filing fee	
108 740	208 370	Reissue filing fee	
114 160	214 80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
110	71 = 39	9	351
10	10 = 0	0	0
Multiple Dependent	10**		

Large Entity	Small Entity	Fee Description
Fee Code (\$)	Fee Code (\$)	
103 18	203 9	Claims in excess of 20
102 84	202 42	Independent claims in excess of 3
104 280	204 140	Multiple dependent claim, if not paid
109 84	209 42	** Reissue independent claims over original patent
110 18	210 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) 351.00

*or number previously paid, if greater. For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity | Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
105 130	205 65	Surcharge - late filing fee or oath	
127 50	227 25	Surcharge - late provisional filing fee or cover sheet	
138 130	139 130	Non-English specification	
147 2,520	147 2,520	For filing a request for ex parte reexamination	
112 920*	112 920*	Requesting publication of SIR prior to Examiner action	
113 1,840*	113 1,840*	Requesting publication of SIR after Examiner action	
115 110	215 55	Extension for reply within first month	
116 400	216 200	Extension for reply within second month	
117 920	217 460	Extension for reply within third month	
118 1,440	218 720	Extension for reply within fourth month	
128 1,960	228 980	Extension for reply within fifth month	
119 320	219 160	Notice of Appeal	
120 320	220 160	Filing a brief in support of an appeal	
121 280	221 140	Request for oral hearing	
138 1,510	138 1,510	Petition to institute a public use proceeding	
140 110	240 55	Petition to revive - unavoidable	
141 1,280	241 640	Petition to revive - unintentional	
142 1,280	242 640	Utility issue fee (or reissue)	
143 480	243 240	Design issue fee	
144 620	244 310	Plant issue fee	
122 130	122 130	Petitions to the Commissioner	
123 50	123 50	Processing fee under 37 CFR 1.17(a)	
126 180	126 180	Submission of Information Disclosure Stmt	
581 40	581 40	Recording each patent assignment per property (times number of properties)	
146 740	246 370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149 740	249 370	For each additional invention to be examined (37 CFR § 1.129(b))	
179 740	279 370	Request for Continued Examination (RCE)	
169 900	169 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

SUBMITTED BY

Name (Print/Type)

Gary R. JarosikRegistration No.
(Attorney/Agent)35,906

Complete (if applicable)

Telephone

312-715-4000

Signature

Date

January 15, 2002

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Search Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on this form should be directed to the U.S. Patent and Trademark Office, Washington, DC 20231.



HUNTON & WILLIAMS LLP
1900 K STREET, N.W.
WASHINGTON, D.C. 20006-1109

TEL 202-955-1500
FAX 202-778-2201

September 22, 2003

RODGER L. TATE
DIRECT DIAL 202-419-2069
EMAIL: rtate@hunton.com

VIA FACSIMILE AND FED EX

TREVOR Q. CODDINGTON
DIRECT DIAL: 202-955-1587
EMAIL: tcoddington@hunton.com

FILE NO: 63044.5

Rattan Nath
Pennie & Edmonds LLP
1155 Avenue of the Americas
New York, N.Y. 10036-2711

Re: U.S. Patent Application No. 10/035,952
Filed: December 26, 2001
Entitled: SYSTEM AND METHOD FOR AUTHORIZING AND PROVIDING
INFORMATION RELEVANT TO A PHYSICAL WORLD
Your Ref.: 11326-003
Our Ref.: 63044.5

Dear Mr. Nath:

We acknowledge receipt today of your facsimile in the evening of September 17, 2003, requesting us to countersign and return your proposed response to the United States Patent & Trademark Office's first Office Action in the above-referenced patent application. As you probably know, our office was closed on Thursday and Friday of last week due to hurricane Isabel. Your letter misstates the nature of our observations about your proposed response. Although we find your technical arguments for overcoming the outstanding prior art rejections are not incorrect or inconsistent with the technical positions that Mr. Rajasekharan has taken in his case, the overall approach of this response is certainly adverse to Mr. Rajasekharan's interests as it continues Ms. Kovesdi's pursuit of claims solely conceived by Mr. Rajasekharan, i.e., renumbered claims 1-42 and 45-70. As you are certainly aware by now, these claims are being pursued in U.S. Patent Application No. 09/987,587, which based on the support provided to us by Mr. Rajasekharan correctly names himself as a sole inventor.

As we discussed via telephone earlier that same day, Mr. Rajasekharan believes that at this late stage there is only one acceptable option that preserves both parties rights in the uncontested jointly conceived subject matter, i.e., submitting our proposed response sent to you on May 21, 2003. The parties can then meet to jointly analyze inventorship claim by claim in view of each side's support for the conception of the claimed invention. You agreed that such a resolution attempt was a good idea. We strongly encourage you to follow this course of action and are concerned that if you proceed to file your response without our signature, as you indicated you were inclined to do, that this will result in the application being held abandoned, which is not our client's intention.

**HUNTON &
WILLIAMS**

Rantan Nath
September 22, 2003
Page 2

We note that due to the United States Patent & Trademark Office's closure this past Thursday and Friday because of Hurricane Isabel, a response filed today will be considered timely in view of the original statutory deadline of September 18, 2003.

Sincerely,



Rodger L. Tate

RLT/TQC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Kovesdi et al.	Confirmation No.:	3522
Serial No.:	10/035,952	Art Unit:	2876
Filed:	December 26, 2001	Examiner:	K. Koyama
For:	SYSTEM AND METHOD FOR AUTHORING AND PROVIDING INFORMATION RELEVANT TO A PHYSICAL WORLD	Attorney Docket No.:	11326-0003-999

SUPPLEMENTAL RESPONSE UNDER 37 C.F.R. § 1.111

Commissioner for Patents
PO BOX 1450
Alexandria, VA 22313-1450

Sir:

In the above-captioned case, the two representatives of the each of the two inventors are required to sign communications to the US Patent Office in accordance with the decision on Noting Joinder of Inventors (Paper No. 12) dated September 12, 2002. In response to the Office Action mailed March 18, 2003 in the above captioned case on September 18, 2003, applicants filed an amendment ("the substantive September 18 response") that was not countersigned by a representative of inventor Ajit Rajasekharan.

Enclosed in this supplemental response is a communication from Mr. Tate, an attorney for inventor Rajasekharan, confirming that the substantive September 18 response is neither incorrect nor inconsistent with positions taken by inventor Rajasekharan in application No. 09/987,597 (naming only Mr. Rajasekharan as an inventor). The enclosed communication further confirms that Mr. Rajasekharan also does not intend the present application to go abandoned. However, having Mr. Tate countersign the response has continued to be challenge in view of his insistence on canceling 68 out of 70 pending claims of the present application, instead of filing the substantive September 18 response. It is believed that the withholding of formal assent from the admittedly technically correct and consistent response is a violation of the duty to cooperate imposed by the Decision in Paper 12.

The Examiner is respectfully requested to accept the enclosed communication as a substitute assent by inventor Rajasekharan to the filing of the substantive September 18 response. This supplemental response is timely because the US Patent Office was closed from September 18 to 21 due to Federal holidays and a intervening weekend.

Following the entry of the substantive September 18 response, all of the pending claims are placed in form for allowance. No new matter has been introduced by way of any of the amendments to the claims or the specification. Applicants respectfully request that they be allowed to proceed to issuance without delay.

No additional fee is estimated to be required for this supplemental response. Please charge any required fee to Deposit Account No. 16-1150.

Date September 22, 2003

Respectfully submitted,



Rattan Nath (Reg. No. 43,827)
for
Ognjan V. Shentov (Reg. No. 38,051)
Attorneys for inventor Kovesdi
PENNIE & EDMONDS LLP
1155 Avenue of Americas
New York, N.Y. 10036-2711
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,952	12/26/2001	Rozsa Kovesdi	11326-0003-999	3522
20583	7590	12/16/2003	EXAMINER	
PENNIE AND EDMONDS 1155 AVENUE OF THE AMERICAS NEW YORK, NY 100362711			KOYAMA, KUMIKO C	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Amendment 11/6/04 @

REFERRED TO <u>R. Nath</u>
REC'D
DEC 18 2003
Pennie & Edmonds
O.K. for filing _____

2372

Office Action Summary

Application No.

10/035,952

Applicant(s)

KOVESDI ET AL.

Examiner

Kumiko C. Koyama

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Acknowledgement is made of receipt of Response filed on September 18, 2003 by the first attorney, Mr. Rattan Nath from Pennie & Edmonds LLP.
2. Acknowledgement is made of receipt of supplemental Response filed on September 22, 2003 by the first attorney, Mr. Rattan Nath from Pennie & Edmonds LLP, concerning the communication between Mr. Rattan Nath and Mr. Rodger L. Tate from Huton & Williams.
3. The reply filed on September 18, 2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): The Amendment filed on September 18, 2003 lacks signature from an inventor's representative Mr. Rodger L. Tate, or from Hunton & Williams. The supplemental response filed on September 22, 2003 is not considered as a signature from Mr. Rodger L. Tate because the supplemental response only shows a correspondence between the two representatives, Mr. Rattan Nath from Pennie & Edmonds LLP and Mr. Rodger L. Tate from Hunton & Williams, and does not represent a signature for the Amendment filed on September 18, 2003. Appropriate signatures from both representatives are required for consideration of Amendment. See MPEP § 402.10 and 403 as well as 37 CFR 1.33. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

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4. The following is a courtesy copy of the previous Office Action mailed March 18, 2003.

Claim Objections

5. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 23, 24, 25...69, 70, 71 have been renumbered 22, 23, 24...68, 69, 70 respectively.

Double Patenting

6. A rejection is based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1-31, 33-42 and 45-70 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-70 of copending Application No. 09/987597. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 18, 19, 21, 22, 31, 34, 38, 54 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu (US 5,480,306, as cited by the Applicant).

Liu teaches a method and apparatus for providing information relevant to a physical world by reading a bar code associated with a sound data and the code is converted into a memory address pointer pointing to the initial address of the memory area in which the digital sound or pronunciation is stored and the sound applied to a loud speaker system (col 2 lines 35+). Liu teaches that the bar code is printed on visible media, such as paper and plastic slides. The conversion from the bar code to the digital code then to an address pointer is considered be normalizing a read object label associated with object into an object identifier as discussed above. And placing the object identifier into an index table repository and binding the content to the object identifier are taught in Fig 5A and Fig 5B.

Re claim 19: Liu teaches that the language learning apparatus contains a digital sound data memory means (col 6 lines 30-32).

Re claim 54: Liu teaches that the memory control means 5 may properly retrieve the desired digital speed data of the word from the memory means 6, which inherently shows that there is not pattern or sequential order for accessing, therefore it is randomly accessible.

Re claim 58: The apparatus is a purpose build device targeted to read bar code.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-5, 9, 13, 16, 29, 30, 39-42, 59, 60, 63-64 and 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (US 5,480,306) in view of Savchenko et al (US 6,111,567).

Liu teaches a method and apparatus for reading a bar code associated with a sound data and the code is converted into a memory address pointer pointing to the initial address of the memory area in which the digital sound or pronunciation is stored, converted to an analog signal, and the sound applied to a loud speaker system (col 2 lines 35+). The apparatus 10 is considered to be a circuitry. Liu teaches that the bar code is printed on visible media, such as paper and plastic slides. Liu teaches that the apparatus having a memory and a speaker means for outputting the sound (col 6 lines 22-59).

Liu fails to teach a method for authoring information and a system for authoring the content.

Savchenko teaches methods of authoring multimedia titles (col 1 lines 8-10).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order

Art Unit: 2876

to create a well organized system so that minimal memory is utilized, but at the same time provide a good quality sound and maintain the flow of the music or sound produced.

Re claim 2 and 3: Liu fails to teach that the system for authoring content is resident in the apparatus.

Savchenko teaches that the execution instructions for the authoring tool are contained in the memory (col 4 lines 39-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to provide a multifunctional apparatus so that the user may author and playback the sound according to his/her preference utilizing only one apparatus, which avoids complicated connections between multiple devices.

Re claim 9: Liu fails to teach that the step of storing the content in non-volatile memory resident in the apparatus.

Savchenko teaches that a computer application 42 is stored in the non-volatile memory 34 (col 4 lines 37-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to safely store the content so that the content is not easily changed or modified by others.

Re claim 13: Savchenko further teaches a computer readable storage media having instructions for authoring information (col 4 lines 39-47).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order

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to speed up the process by storing all the instruction in the memory and have the processor access and execute the instructions instead of loading or inputting the instructions one-by-one by the user.

Re claim 16, 29 and 30: In addition to Liu as modified by Savchenko discussed above, the conversion from the bar code to the digital code then to an address pointer is considered be normalizing a read object label associated with object into an object identifier as discussed above. And placing the object identifier into an index table repository and binding the content to the object identifier are taught in Fig 5A and Fig 5B.

Re claim 42: Liu teaches that rendering digital multimedia as a function of output capabilities of the apparatus (col 6 lines 50-58).

Liu fails to teach programming that renders digital multimedia as a function of output capabilities.

Savchenko teaches a computer application 42 that executes instructions (col 4 lines 36-45).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to provide the proper sound signal that matches the output characteristics of the apparatus so that the user can listen to a good quality sound with less background noise and interruption.

Re claim 63: Liu teaches that a keyboard for inputting information (col 1 lines 13-25).

12. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 above and Liu as applied to claim 18, and further in

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view of Cave (US 5,958,014). Liu as modified by Savchenko and Liu have been discussed above.

Liu as modified by Savchenko and Liu fail to teach that the content is a link to a live agent.

Cave teaches device having audio capabilities and can be connected to a live agent (col 1 lines 65+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cave to the teachings of Liu as modified by Savchenko in order to provide a two-way audio or text exchange to communicate with each other without remembering or dialing numbers, which also makes the process faster.

13. Claims 7, 14, 36, 37, 49 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 and 13 above and Liu as applied to claim 38, and further in view of Conley, Jr. et al (US 6,434,745).

Liu teaches receiving a plurality of optical codes (col 7 line 45).

Therefore, it would have been obvious to utilize the steps of Liu as modified by Savchenko and repeat steps for as many coded labels necessary because it is a mere duplication of process.

Liu as modified by Savchenko fails to teach aggregating the content into a single logical entity called a tour.

Conley teaches that a tour component of the browser 8 allows the end-user to identify one or more URLs and save them into a group called a tour and to create one or more such tours, and

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to save each tour to a searchable local tour database on the end-user computer 14 similar to the searchable local image database.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Conley to the teachings of Liu as modified by Savchenko in order to organize the data so that related data are grouped in the same group. Such modification helps and speeds up the searching process when the data needs to be retrieved because the data are

14. Claims 8, 15, 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 and 13 above and Liu as applied to claim 31 above, and further in view of Brooks et al (US 4,963,719).

Liu as modified by Savchenko fails to teach detecting a second label associated with the first object and normalizing the first label and the second label such that the content bound to the first object can be rendered during detection of either the first or second label in the playback mode.

Brooks teaches two labels associated with the same object, two labels attached to an object and detecting two of the labels (Fig 2, col 2 lines 26+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Brooks to the teachings of Liu as modified by Savchenko so that plurality of bar code labels having the same sound or data may be provided on different or multiple appliances for duplication or convenience purposes.

15. Claim 10, 11, 12, 20, 25, 45-47 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 1 and 64 above and over

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Liu as applied to claim 18, 38 above, and further in view of Cluts (US 5,616,876). Liu as modified by Savchenko and Liu have been discussed above.

Re claim 10, 20, 45 and 65: Liu as modified by Savchenko and Liu fail to teach a step of uploading and downloading the content to a remote server.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Savchenko because a remote server may provide more memory or storage space, which allows more data and information to be stored.

Re claim 11 and 47: Liu as modified by Savchenko fails to teach that the step of uploading is performed via a wireless network.

Cluts teaches a communication link is wireless (col 7 lines 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Savchenko because it does not require wired connection, therefore provides mobility and convenience.

Re claim 12 and 46: Liu as modified by Savchenko fails to teach that the step of uploading is performed via a wired network.

Cluts teaches a communication link is wired (col 7 lines 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by

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Savchenko because the possibility of data loss or corruption in transferred data decreases, therefore the modification provides a more accurate transmission of the data.

Re claim 25: Liu fails to teach that the step of rendering the content comprises streaming the content from a remote server.

Savchenko teaches rendering the content comprise streaming the content (col 1 lines 28-31).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Savchenko to the teachings of Liu in order to transmit the sound file through communication links using industry standards, such as MPEG standards.

Liu as modified by Savchenko fails to teach a remote server.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Savchenko because a remote server may provide more memory or storage space, which allows more data and information to be stored.

16. Claims 17, 62 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claims 16, 59 and 64 above, and further in view of Bridgelall (US 6,264,106). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fail to disclose that the instructions allow a plurality of different label types to be normalized to one object identifier.

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Bridgelall teaches a combination bar code scanner/RFID circuit for reading bar code or RFID (col 2 lines 20+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Bridgelall to the teachings of Liu as modified by Savchenko because bar code and RFID tags are commonly known forms of identification and combining those two functions into one device will provide the flexibility of reading different types of codes.

17. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 18 above, and further in view of Fan et al (US 6,324,165). Liu has been discussed above.

Liu fails to teach determining the current time and comparing the current time to the timestamp before rendering the content.

Fan teaches a timer issuing a current time and a comparator for comparing the queue timestamp to the current time (col 27 lines 7-12).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Fan to the teachings of Liu in order to provide a data that corresponds to the current time by checking to see if the current time and timestamp corresponds to each other.

18. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 18 above, and further in view of Boulton et al (US 5,566,291). Liu has been discussed above.

Liu further teaches that the language learning apparatus contains a digital sound data memory means (col 6 lines 30-32).

Art Unit: 2876

Liu fails to teach that the steps of accepting annotations/feedback after the rendering of the content and binding the annotations/feedback to the object identifier.

Boulton teaches an object identifier field 200 that stores an object identifier which references an object the user may be referencing with his or her feedback information. In Boulton's feedback system, objects can be used to further define the context when the feedback is provided (col 25 lines 55+).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Boulton to the teachings of Liu in order to enhance the content and provide a better quality sound, image, etc. to the user by editing or making additional comments to the content.

19. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Boulton as applied to claim 26 above, and further in view of Cluts.

Liu as modified by Boulton fails to disclose the step of storing the annotations/feedback in a remote memory.

Cluts teaches a remote server 34 utilized to transmit programming information for storage by one or more of the memory storage devices 30 (col 14-27).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cluts to the teachings of Liu as modified by Boulton because a remote server may provide more memory or storage space, which allows more data and information to be stored.

Art Unit: 2876

20. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 31 above, and further in view of Swartz et al (US 6,095,418). Liu has been discussed above.

Liu fails to teach that at least one of the plurality of labels is custom created.

Swartz teaches translating the MIDI code to a symbol data and to music print data. The printer 26 then prints the symbol data as symbol 14.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Swartz to the teachings of Liu in order to provide custom created bar code so that information regarding the content's location within the database or other information may be encoded according to the program or application that is used for the system.

21. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 38 above, and further in view of Hollander (US 4,037,302) and Blum (US 4,654,727). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fail to teach that the physical world comprises labeled locations containing labeled mobile objects and the labeled locations are used to determine proximity of the labeled mobile objects.

Holland teaches labeled locations, such as labeled bin or labeled shelf (col 4 lines 48-51).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Holland to the teachings of Liu as modified by Savchenko in order to identify the purpose, use or the physical description of the location of the labeled location so that the locations can easily and quickly identified.

Art Unit: 2876

Blum teaches that a bar code label on the cassette is read by a bar code reader in order to enable a computer control system to determine the location of the cassette and control the subsequent transport of cassettes to the tape transports (col 1 lines 40-45).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Blum to the teachings of Liu as modified by Savchenko in order to quickly and easily determine the location of the object by using the bar code label as a tracking method, which also avoids the object from getting lost.

22. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko and Cluts as applied to claim 47 above, and further in view of Aguirre et al (US 6,195,531). Liu/Savchenko/Cluts have been discussed above.

Liu/Savchenko/Cluts fails to teach that the wireless network comprises a cellular telephone network.

Aguirre teaches a cellular telephone network (col 3 lines 26-40).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Aguirre to the teachings of Liu/Savchenko/Cluts because it is a widely used wireless network method for providing a safe and reliable data transmission, which enhances the accuracy of the data being transmitted.

23. Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Cole et al (US 6,359,711). Liu have been discussed above.

Liu fails to disclose that the apparatus accesses the tour via the internet and a voice portal.

Art Unit: 2876

Cole teaches a portable computer with access methods of voicemail and internet (col 2 lines 10-15).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cole to the teachings of Liu because it is a fast method to communicate and transmit data using a conventional phone line, which is commonly available.

24. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Aguirre and Cole.

Liu fails to teach that the apparatus accesses the tour via a cellular telephone voice mailbox.

Aguirre teaches a cellular telephone network (col 3 lines 26-40).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Aguirre to the teachings of Liu/Savchenko/Cluts because it is a widely used wireless network method for providing a safe and reliable data transmission, which enhances the accuracy of the data being transmitted.

Cole teaches a portable computer with access methods of voicemail and internet (col 2 lines 10-15).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Cole to the teachings of Liu because it is a fast method to communicate and transmit data using a conventional phone line, which is commonly available.

Art Unit: 2876

25. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Krueger (US 5,598,540). Liu has been discussed above.

Liu fails to teach that the digital multimedia is accessible by the apparatus in a sequential order.

Krueger teaches accessing the stored data only in sequential order (Abstract).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Krueger to the teachings of Liu in case presentation of the digital multimedia must be in a certain order for the user to understand certain topics before achieving the next data so that the next data makes more sense to the user.

26. Claims 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as applied to claim 38 above, and further in view of Ramachandran (US 6,315,195). Liu has been discussed above.

Liu fails to teach that the apparatus comprises a personal digital assistant and a cellular telephone.

Ramachandran teaches a portable terminal 14 that reads bar codes and also may be integrated into a carrier 62, which may be a personal digital assistant or a cellular phone (col 8 lines 23-26, col 9 lines 35-42).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Ramachandran to the teachings of Liu because both personal digital assistant and cellular phones have the capability of storing information and also wirelessly transmitting information through internet and other communication methods, which enhances the voice data and play back as well.

Art Unit: 2876

27. Claims 61 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 59 and 64 above, and further in view of Chen et al (US 5,869,820). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fails to teach that the circuitry comprises an IR tag reader.

Chen teaches an infrared tag reader (col 8 line 5).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Chen to the teachings of Liu as modified by Savchenko because IR tags are readily available tags that are also used for identification purposes and it utilizes wireless communication, which provides mobility and faster process.

28. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu as modified by Savchenko as applied to claim 64 above, and further in view of Bertram et al (US 5,613,137). Liu as modified by Savchenko have been discussed above.

Liu as modified by Savchenko fails to teach a circuitry determining a coordinate location.

Bertram teaches a coordinate determining circuitry 302 configured to determine corresponding locations of the touch on the coordinate sensor (col 15 lines 20-28).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Bertram to the teachings of Liu as modified by Savchenko in order to determine the location of the touch pad sensor input that provides the information regarding the identification of the content to be retrieved and played back.

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Savchenko et al., U.S. Patent No. 6,343,298, discloses a seamless multimedia branching.

Kikuda, U.S. Patent No 4,952,785, discloses a bar code generating apparatus for image communication terminal device.

Raistrick et al., U.S. Patent No. 5,971,279, discloses a hand held scanner for the visually impaired.

Citron et al., U.S. Patent No. 5,288,976, discloses a bar code use in information, transactional and other system and service applications.

Kunizawa et al., U.S. Patent No. 4,964,167, discloses an apparatus for generating synthesized voice from text.

Knowles discloses a hand-held portable www access terminal with visual display panel an gui-based www browser program integrated with bar code symbol reader in a hand-supportable housing.

Hoda et al., U.S. Patent No. 4,831,610, discloses method and apparatus for interactive control of a data recording medium playback apparatus using bar code access.

Barton et al., U.S. Patent No. 5,998,752, discloses a sorting system.

Dyko et al, U.S. Patent No. 5,956,708, discloses an integration of link generation cross-author user navigation, and reuse identification in authoring process.

Wilz, Sr. et al., U.S Patent No. 5,992,752, discloses an internet-based system for enabling information-related transactions over the internet using java-enabled internet terminals provided with reading java-applet encoded bar code symbols.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 703-305-5425. The examiner can normally be reached on Monday-Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Kumiko C. Koyama
Kumiko C. Koyama
December 03, 2003

Diane I. Lee
DIANE I. LEE
PRIMARY EXAMINER

Rattan Nath

From: Rattan Nath
Sent: Thursday, January 15, 2004 11:35 AM
To: 'Tate, Rodger'
Cc: Ognjan Shentov
Subject: RE: Signature on the Response to the Office Action
Importance: High

Dear Mr. Tate:

You are the one who is missing the point. It is your duty to allow this application to be prosecuted properly so that, if necessary, an interference proceeding rather than interference from you decides the inventorship. Despite ample opportunities, you have been unable to come with any evidence to show that Ajit is properly named as a sole inventor. As you well know, merely repeating that your evidence is 'overwhelming' is insufficient as a matter of law to prove inventorship. It may, however, provide evidence of lack of good faith in addressing the underlying issues.

Therefore, as to inventorship, leave it for the PTO to decide. There is no business meeting in the works either. Unless you are angling to cut out the PTO from adjudicating the matter, send me the executed response without delay for filing no later than tomorrow. Any delay at this juncture is just another breach of the duty of good faith.

Regards,

Rattan

-----Original Message-----

From: Tate, Rodger [mailto:rtate@hunton.com]
Sent: Thursday, January 15, 2004 10:15 AM
To: Rattan Nath
Cc: Coddington, Trevor
Subject: RE: Signature on the Response to the Office Action

Dear Rattan,

You seem to have missed the point I was trying to make in our telephone conversation the other day. We have always stated that we believe the record and the facts as communicated to us by our client lead to the conclusion that Rozi and Ajit were the joint inventors of a few of the claims in your case, but not the rest. Those claims that we believe are the sole invention of Ajit are pending in our sole case. Until we hear from Rozi what the basis for her assertion that she is a joint inventor on more of the claims, we cannot in good faith pursue claims in the joint case that we do not believe are jointly invented. Our call for a meeting with Rozi is primarily about resolving this issue. I have stated, and believe that while we are at the table, all other issues between the parties should be resolved. We are not refusing to cooperate in prosecuting the joint case, we are merely seeking your assistance in understanding the facts your client believes support her view before we file the next response. We suggested this meeting months ago and your client refused then and continues to refuse. Your continued demands that we accept your position without providing us the basis for it, does nothing to advance your client's interests.

If you do not wish to take an extension of time to permit such a meeting, you can choose to let the case go abandoned. Those three claims that we seem to agree were jointly invented may be lost by this action, but the remaining claims are pending in our sole case.

1/15/2004

Please advise if based on the foregoing clarification of our position, Rozi is willing to meet to provide us with the basis for her position.

-----Original Message-----

From: Rattan Nath [mailto:rnath@Jonesday.com]

Sent: Wednesday, January 14, 2004 10:16 AM

To: Tate, Rodger

Cc: Ognjan Shentov

Subject: Signature on the Response to the Office Action

Importance: High

Dear Mr. Tate:

Thank you for the discussion yesterday regarding the filing of the response in the US patent application No. 10/035,952. As promised, I spoke to Ms. Kovesdi and let her know that you were linking the signature on the proposed response to a meeting with her to address some business issues unrelated to the prosecution of the application. I also let her know that in the absence of such a meeting being scheduled, you were not going to sign the response in time for it to be filed with the PTO by the due date of January 16, 2004.

At this point, any such meeting has been ruled out. Thus, there is no reason to withhold the signature in the hope for such a meeting any time soon.

Accordingly, please sign the proposed response and send at least the signature page back to me via facsimile (facsimile # 212-699-0338) in time for filing it with the PTO on January 16, 2004. Please also send the originals by mail separately.

Thank you for the tip on the adverse PTO ruling on our petition for correcting the defective inventorship in the case filed by Ajit. Please send us a copy of the file (all of the public papers) for the case filed by Ajit (Serial No. 09/987,597). We have requested these non-confidential documents previously as well without getting a response. Hopefully, this time we will see more cooperation.

If you have any questions, please do not hesitate in contacting us.

Regards,

Rattan

1/15/2004



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O. Box 1450
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www.uspto.gov

Paper No. 8

TREVOR CODDINGTON
HUNTON & WILLIAMS
1900 K STREET NW
WASHINGTON, DC 20006-1109

COPY MAILED

JAN 12 2004

OFFICE OF PETITIONS

In re Application of :
Rajasekharan : LETTER
Application No. 09/987,597 :
Filed: November 15, 2001 :
Atty. Dkt. No.: 033393.0003 :

This letter is in response to the petitions filed April 21, 2003 under 37 CFR 1.182 and 37 CFR 1.48.

The petitions will not be treated on the merits as petitioner has failed to establish that he is a proper party in interest, i.e., inventor or assignee.

The inventorship of the instant application was set forth in a properly executed oath or declaration signed by the inventor(s) of record pursuant to 35 USC 115, 35 USC 116, and 37 CFR 1.63. Accordingly, any change in inventorship must be requested by the inventor(s) named in the first executed oath or declaration pursuant to 37 CFR 1.48, and, if applicable, an assignee pursuant to 37 CFR 3.73(b).

As there is no indication in Office records that petitioner herein was ever empowered to represent the instant application, the requested change of power of attorney and correspondence address will not be entered into the record.

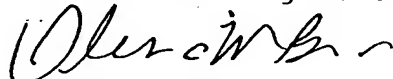
Petitioner is entitled to a refund of the previously submitted petition fees totaling \$260.00. A refund may be requested by writing to the Finance Office, Refund Section. A copy of this letter should accompany any request for refund.

This application is being returned to the appropriate Technology Center for further processing.

Application No. 09/987,597

2

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0310.



Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

CC: ROZSA KOVESDI
70 DERBY COURT
MADISON, NJ 07940



HUNTON & WILLIAMS LLP
1900 K STREET, N.W.
WASHINGTON, D.C. 20006-1109

TEL 202 • 955 • 1500
FAX 202 • 778 • 2201

RODGER L. TATE
DIRECT DIAL: 202-419-2069
EMAIL: rtate@hunton.com

April 8, 2004

FILE NO: 63044.000005

VIA FACSIMILE

Rattan Nath
Jones Day
222 East 41st Street
New York, N.Y. 10017-6702

Re: Kovesdi Matter

Dear Mr. Nath:

I am in receipt of your letter of April 1, 2004. We are disappointed by your client's continued refusal to meet and try to resolve these issues. Her motives in taking this position are a mystery to us. We repeat that Readia remains willing to have the face-to-face meeting we have proposed on numerous occasions, and urge Rozi to reconsider this position.

We continue to find her broad unsupportable position that she is a co-inventor untenable. We have provided facts and contextual explanations supporting Readia's position and Rozi has continued to simply demand she be added pointing only to out-of-context statements by Ajit who did not understand the law of co-inventorship at the time he made them.. At the proposed meeting, we think both parties should provide any documentary evidence supporting their positions on inventorship so an informed, good faith resolution of this dispute could occur.

Frankly, my client finds incredulous Rozi's increasingly broadening positions that she contributed, as a co-inventor, to the coincident authoring concept or the pen-shaped device form factor concept. I am sure you have advised Ms. Kovesdi that she has, and will have, the **burden** to establish facts supporting her claim of co-inventorship. As you will appreciate, the claim to co-inventorship on the design patent is also legally spurious as design patents do not cover "ideas" but ornamental designs. The facts are clear that Rozi had nothing to do with the later-developed specifics of the patented design.

Despite Rozi's continued refusal to engage in good faith discussion about this matter, we remain prepared to cooperate with you in taking appropriate action in application Serial No. 10/035,952. In that regard please consider the following proposal. If Rozi is willing to agree to promptly meet and discuss all issues with Readia in good faith, Readia is willing to consider adding what we have consistently viewed as the jointly invented claims (42-43) to our sole

HUNTON WILLIAMS

Rattan Nath
April 8, 2004
Page 2

case (Serial No. 09/987,597) and adding her name to that case as a co-inventor. Acceptable ground rules for such a proposal include (i) Rozi agrees in writing to discuss and resolve the inventorship issue she raised regarding our CIP (Serial No. 10/103,777) in good faith and to only take positions that are factually supportable by documentary evidence and (ii) Rozi agrees to sign a NonDisclosure Agreement (NDA) containing customary nondisclosure and nonuse provisions covering (a) the prosecution strategy in our CIP and (b) the subject matter disclosed in Readia's recently filed provisionals, which we would share with her subject to the NDA and Rozi's good faith undertaking to review them and formally waive any potential claims of inventorship that she cannot support with documentary evidence.

The proposed process can take place quickly before any action needs to be taken in the '952 application. If Rozi refuses to engage in the process of the above proposal, then please advise us which of the following alternative options you will join us in regarding the '952 application:

- Option 1: Sign the enclosed responsive amendment to continue the prosecution on those patentable claims we have agreed are jointly invented.
- Option 2: Sign a joint Petition to suspend prosecution.
- Option 3: Sign a joint request for the filing of a continuation application.

If you refuse to cooperate with us on all of these proposals, it is likely that the application will become irrevocably abandoned. While we believe that the majority of our client's interest are protected in the sole application we filed, an intentional abandonment resulting from your refusal to cooperate would cause my client loss of rights to the joint subject matter.

Selection of options 2 or 3 would provide for the potential downstream resolution of the dispute by (a) agreement of the parties, (b) arbitration of the dispute or (c) an interference proceeding upon the PTO's determination of allowable subject matter in our sole case.

Please let me have your response by April 12, 2004.

Very truly yours,



Rodger L. Tate

RLT:cbt:mia

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:)	
)	
Rozsa KOVESDI and Ajit RAJASEKHARAN)	Group Art Unit: 2876
)	
Application Number: 10/035,952)	Examiner Kumiko C. KOYAMA
)	
Filed: December 26, 2001)	Confirmation No. 3522
)	
For: SYSTEM AND METHOD FOR)	
AUTHORING AND PROVIDING)	
INFORMATION RELEVANT TO A)	
PHYSICAL WORLD)	

REPLY TO NON-FINAL OFFICE ACTION UNDER 37 C.F.R. § 1.111

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Dear Sir:

In response to the Office Action mailed on March 18, 2003, and the Notice of Non-Responsive Amendment mailed on December 16, 2003, Applicants respectfully request entry of the following amendments and reconsideration of all rejections in view of these amendments and the following remarks.

Amendments to the Claims are reflected in the listing of claims, which begins on page 2 of this paper.

In sum, claims 43 and 44 are amended as follows.¹

Claims 1-42 and 45-109 have been cancelled.

Claims 43 and 44 are currently pending.

Remarks/Arguments begin on page 3 of this paper.

¹ Due to the absence of claim 22 in the application as originally filed, claims 23-110 have been renumbered to claims 22-109, respectively. See Office Action, page 2.

Claims 1-42. (Cancelled)

43. (Currently Amended) [The system as recited in claim 39] A system for authoring and retrieving selected digital multimedia information relevant to a physical world, comprising:
a plurality of machine readable labels relevant to the physical world;
an apparatus for detecting the machine readable labels and including programming for normalizing information contained in the detected label into an object identifier; and
a digital multimedia library accessible by the apparatus storing content indexed by the object identifiers,

wherein the physical world comprises labeled locations containing labeled mobile objects.

44. (Currently Amended) The system as recited in claim [44] 43, wherein the labeled locations are used to determine proximity of the labeled mobile objects.

45-109. (Cancelled)

REMARKS

Claims 43 and 44 are pending. Applicants respectfully request that the Examiner reconsider all rejections in the outstanding Office Action in view of the foregoing amendments and the following remarks.

1. Claims 1-42 and 45-70

Claims 1-42 and 45-70 have been cancelled. Accordingly, all rejections in the instant application with respect to these claims are rendered moot.

Applicants note that these claims are solely conceived by Mr. Ajit Rajasekharan and are therefore being pursued in related U.S. Patent Application No. 09/987,597, which correctly identifies Mr. Rajasekharan as the sole inventor.

2. 35 U.S.C. § 103

Claims 43 and 44 stand rejected under 35 U.S.C. § 103(a), as allegedly rendered unpatentable over U.S. Patent No. 5,480,306 to Liu in view of U.S. Patent No. 6,111,567 to Savchenko, and further in view of U.S. Patent No. 4,037,302 to Hollander and U.S. Patent No. 4,654,727 to Blum. Office Action, page 13. The Examiner concludes that Liu as modified by Savchenko fails to teach that the physical world comprises labeled locations containing labeled mobile objects and the labeled locations are used to determined proximity of the labeled mobile objects. *Id.* In an attempt to cure such a deficiency, Holland is introduced as teaching labeled locations, such as a labeled bin or labeled shelf.² *Id.* Applicants respectfully traverse this rejection on the following grounds.

In order to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143 (citations omitted). In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combinations. *See* M.P.E.P. §§ 2142 and 2143.01; *see also In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.”). It is well-settled that an Examiner can “satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge

² It appears that the Office Action does not rely on Blum with respect to claim 43.

generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); *see also In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (“deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). As with rejections based on the combination of multiple references, “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence [of a motivation to combine]’” and thus do not support rejections based on combining references. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the “essence of hindsight” reconstruction, the very “syndrome” that the requirement for such evidence is designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 USPQ2d at 1617-18.

There is no showing of any objective teaching to combine Liu, Savchenko, and Hollander as applied to claim 43. The Office action merely states: “Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the teachings of Holland to the teachings of Liu as modified by Savchenko in order to identify the purpose, use or the physical description of the location of the labeled location so that the locations can easily and quickly [be] identified.” This broad, conclusory statement is not sufficient, under the controlling authorities set forth above, to justify combining the teachings of these three references. There is no showing that either of the applied references, or any other prior art, even remotely suggests such a combination. Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness.

Even assuming, *arguendo*, that a *prima facie* case of obviousness has been established, Liu, either taken alone or in combination with any of the cited secondary references, fails to teach or suggest all of the limitations of claim 43.

For at least the reasons set forth above, Applicants respectfully submit that the instant rejection is improper and therefore, request that the Examiner withdraw the rejection of claims 43 and 44.

CONCLUSION

Applicants respectfully submit that this application is in condition for allowance, and such disposition is earnestly solicited. Applicants submit concurrently herewith a three-month extension of time and the requisite fee for consideration of this response.

Respectfully submitted,

Dated: _____

By: _____
Rodger L. Tate
Registration No. 27,399
(Representative for Mr. Rajasekharan)
Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, DC 20006-1109

Dated: _____

By: _____
Ognjan V. Shentov
Registration No. 38,051
(Representative for Ms. Kovesdi)
Jones Day
222 East 41st Street
New York, N.Y. 10017-6702

JONES DAY

222 EAST 41ST STREET • NEW YORK, NEW YORK 10017-6702
TELEPHONE: 212-326-9939 • FACSIMILE: 212-755-7906

Direct Number: (212) 790-6536
Direct Fax: (212) 699-0338
nathr@jonesday.com

006596:rxn
CAM

April 1, 2004

By Facsimile

Mr. Rodger Tate
HUNTON & WILLIAMS
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109

Re: United States Patent Application Serial No. 10/035,952
Filed: December 26, 2001
For: SYSTEM AND METHOD FOR AUTHORIZING
AND PROVIDING INFORMATION RELEVANT
TO A PHYSICAL WORLD
By: Kovesdi et al.

Dear Mr. Tate:

I acknowledge your letter dated March 31, 2004. As you know, we would like to find an amicable resolution which is in the best interest of all parties. Still, absent any indication of what new facts or information may be discussed with her, it is our client's belief that there is no point in a face-to-face meeting. In particular, Ms. Kovesdi feels that in view of your inability to provide facts or evidence directed to demonstrating that she is not a co-inventor of the US Patent Application No. 09/987,597 ("the '597 application"), there is little to be gained in any such meeting. We are unable to find any error in her perception based on the evidence provided by you, which we understand was the result of your careful review of the underlying facts. Ms. Kovesdi has already indicated that she is not interested in entering into any business arrangements at this time.

In fact, as you must know from your review of the correspondence, Mr. Rajasekharan has not only acknowledged the broad and deep contributions by Ms. Kovesdi from conception to realization of the invention claimed in the '597 application, but he also has admitted to specific details relevant to the inventorship issue. For instance, in email exchanges Mr. Rajasekharan has admitted that Ms. Kovesdi contributed the "key idea" of coincident authoring to solve the tricky binding problem. This solution undeniably underlies claim 1 of the '597 application. Similarly, Mr. Rajasekharan also admitted that Ms. Kovesdi originated the idea for a pen-shaped device, which is a significant part of the pending US Patent Application No. 10/103,777 naming Mr. Millman as a co-inventor.

Doc ID

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Mr. Rodger Tate, Esq
April 1, 2004
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Mr. Rajasekharan's admissions clearly support Ms. Kovesdi's proper status as an inventor. Accordingly, unless Ms. Kovesdi is included as an inventor on all of the applications, resolution of this dispute is unlikely. Please provide us with details on the other patent applications that you seem to have filed to allow us to correct the record, if required. In particular, it would appear that Ms. Kovesdi should be named a co-inventor of the design patent disclosed in your letter as she undeniably contributed the idea of a pen-shaped device.

Based on the above, if your client is seriously considering a resolution, we ask you to countersign the copy of the response to the pending Office Action in the above-captioned case and send it to me no later than 4:00 pm on Tuesday, April 6, 2004. We can then discuss the mechanics for adding Ms. Kovesdi as a co-inventor to the various applications as soon as possible. If you have any questions, please let us know.

Best regards,

A handwritten signature in black ink, appearing to read "Rattan Nath", with a stylized flourish at the end.

Rattan Nath
Associate

c: Ognjan Shentov, Esq.



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FILE NO: 63044 000001

March 31, 2004

Rattan Nath
Jones Day
1155 Avenue of the Americas
New York, N.Y. 10036-2711

Re: Kovesdi Matter

Dear Mr. Nath:

It has been sometime since we last discussed the dispute between our clients. Please let me know if you have filed any further papers in the dual representation case naming Ms. Kovesdi and Ajit. I understand that the period to respond to the PTO's notice of non responsiveness will expire, with extension, on June 16, 2004.

While you and I have agreed on several occasions, that it makes good sense to both our clients to put this dispute behind them, we have not been able to get them to talk about this. I believe it is appropriate to try one more time.

In the context of a global resolution of all issues we would like to hear Ms. Kovesdi's position on what contributions she made to the first provisional case she and Ajit filed, and my client has reaffirmed its willingness to reevaluate the inventorship position on this case based on what Ms. Kovesdi has to say.

While we believe that the meeting we are proposing should include a discussion of possible business resolutions, the primary purpose of the meeting will be to attempt to reach an agreement on the inventorship issues by mutually discussing the legally relevant facts.

As to the second case our client filed (SN 10/103,777) we are prepared to explain why the claims being pursued there do not relate to any potentially jointly invented subject matter. A design patent just issued (U.S. Des. 487746) on a device developed long after our clients stopped talking to one another. Our client also has recently filed a number of provisional applications directed to new technology developed long after the period of interaction. This technology is so clearly different that it will not be subject to these discussions.

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WILLIAMS**

Rattan Nath
March 31, 2004
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I would like your thoughts on who you think should attend this meeting. I propose that both Rozi and Ajit and you and I would be the most productive. If you think that mix is too explosive, maybe only you, I and Rozi could meet.

Please let me have your thoughts on how we can tie up these loose ends in a win-win manner.

Very truly yours,



Rodger L. Tate

RLT:mia